Supreme Court, U.S.
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NO. 01-

IN THE

Supreme Court Of The United States

INTERMATIC INCORPORATED,

Petitioner,

V.

THE LAMSON & SESSIONS CO.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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JOHN K. LUCAS
(*Counsel of Record*)
HAROLD V. JOHNSON
TIMOTHY Q. DELANEY
MARK H. REMUS
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, Illinois 60611
(312) 321-4200
Counsel for Petitioner

QUESTION PRESENTED FOR REVIEW

The Federal Circuit's decision in this case rests on the complete bar rule announced in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000) (en banc). This Court rejected the complete bar rule and vacated the Federal Circuit's *Festo* decision on May 28, 2002. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. __, 122 S. Ct. 1831 (2002).

The question presented for review is:

> Should the decision of the Federal Circuit stand when this Court has squarely rejected the rule of law on which it was based.

STATEMENT PURSUANT TO RULE 29.6

Petitioner, Intermatic Incorporated, states that it has no parent company and that no publicly held companies own 10% or more of Petitioner's stock.

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Intermatic Incorporated hereby petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINION BELOW

The Federal Circuit's panel decision affirming-in-part, reversing-in-part the judgment of the district court in *Intermatic I*, and affirming the judgment of the district court in *Intermatic II*, is reported at 273 F.3d 1355 (Fed. Cir. 2001) (App. 1a-25a).[1]

STATEMENT OF JURISDICTION

The Federal Circuit entered its opinion and order on December 17, 2001 (App. 1a), and denied Intermatic's petition for rehearing *en banc* on February 6, 2002 (App. 26a-27a). On April 30, 2002 the Chief Justice extended the time for filing this petition for certiorari to and including June 7, 2002. On June 3, 2002 the Chief Justice extended the time for filing this petition for certiorari to and including July 5, 2002. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1); *see also* S. Ct. Rule 13(3).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article 1, section 8, clause 8 of the Constitution provides:

> "Congress shall have the power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

---

[1] References to App. __ are to the Appendix found at the close of this Petition.

35 U.S.C. § 271(a) provides:

> "Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the Unites States or imports into the United States any patented invention during the term of the patent therefore, infringes the patent."

STATEMENT OF THE CASE

1. Introduction

In a single opinion the United States Court of Appeals for the Federal Circuit resolved two separate, but related, patent infringement actions. The actions involve the same parties and the same patent, but different products.

In the first action ("*Intermatic I*"), a jury found that Respondent, Lamson & Sessions Co., copied Intermatic's commercial product and willfully infringed Intermatic's valid U.S. Pat. No. 5,280,135 ("the Berlin patent"). The district court confirmed the jury verdict, and Lamson appealed to the Federal Circuit.

The second action ("*Intermatic II*") concerns Intermatic's contention that a redesigned product that Lamson introduced immediately after the jury verdict in *Intermatic I* also infringes the Berlin patent. Lamson successfully moved for summary judgment of non-infringement, and Intermatic appealed to the Federal Circuit.

Each appeal was separately briefed and argued. The Federal Circuit vacated the jury verdict in *Intermatic I*, and affirmed the summary judgment of non-infringement in *Intermatic II*, based on its intervening decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki*

Co., Ltd., 234 F.3d 558 (Fed. Cir. 2000) (en banc), *vacated and remanded*, 535 U.S. ___, 122 S. Ct. 1831 (2002).

2. The Invention of The Berlin Patent

The weatherproof outlet cover claimed in the Berlin patent protects an outdoor electrical outlet from moisture while the outlet has a cord plugged into it. Prior to the Berlin invention, outlet covers were tailor-made for use with just one type of outlet configuration. The Berlin invention enables a single cover to be used with multiple outlet configurations through the use of interchangeable inserts that can be mounted in the base of the cover. The covers come with an assortment of inserts, each of which corresponds to a common outlet configuration. The inserts have structure that extends into the aperture of the base to perform important functions relating to moisture protection and safety. Intermatic filed the application for the Berlin patent on August 9, 1991, and started selling its new covers shortly thereafter.

The Berlin patent was issued by the United States Patent and Trademark Office ("the PTO") on January 18, 1994. Claims 1-13 require a weatherproof cover with inserts that fit or are accommodated "within the aperture of the base." Claims 14-19 required a weatherproof cover with inserts "adapted to be mounted in the base." (As discussed below, claim 14 was later amended during a reexamination of the Berlin patent by the PTO.)

3. Intermatic I

Lamson's Infringing Products In Intermatic I. When Intermatic launched its patented product, Lamson obtained and studied Intermatic's outlet cover. Lamson copied Intermatic's cover and began selling an infringing product. The inserts sold with Lamson's product consist

of a rectangular plastic plate having openings. Reinforcements surround the openings and extend down from the insert's back face. These reinforcements are referred to by the parties as "ribs." Just like the preferred embodiment of the Berlin patent, the Lamson products have a plate with a lower part that extends into and penetrates the aperture in the base. Intermatic contends that Lamson's inserts with ribs are accommodated "within the aperture of the base" as required by the relevant claims.

The Intermatic I District Court Proceedings. Intermatic filed suit against Lamson in September 1994. Lamson responded by filing two requests for reexamination of the Berlin patent, both of which were granted by the PTO, and merged into a single proceeding. The district court stayed the litigation between Intermatic and Lamson pending resolution of the reexaminations.

The patentability of claims 1-13, 16-17 and 19 was confirmed by the PTO Examiner without any amendment to the claims. Independent claim 14 and dependent claims 15 and 18 stood rejected after the patentability of claims 1-13, 16-17, and 19 was confirmed. To conclude the time-consuming reexamination and enable the litigation to move forward, Intermatic amended claim 14 to specify that the insert of claim 14 is "accommodated within the aperture of the base" rather than "adapted to be mounted in the base." The reexamination certificate, confirming the patentability of original claims 1-13 and 19 and amended claims 14-18, was issued in January 1998.

In September 1999, Intermatic's case was tried to a jury. The jury found that Lamson copied Intermatic's patented

product and willfully infringed claims 1, 3, 4, 6-9, and 11-18 of the Berlin patent. The jury awarded Intermatic $12.5 million in damages, and the district court enjoined Lamson from making the *Intermatic I* products. Lamson appealed to the Federal Circuit

4. Intermatic II

Lamson's Infringing Products In Intermatic II. In response to the jury verdict and judgment of the district court in *Intermatic I*, Lamson made an insubstantial change to its infringing products. While the first generation insert had ribs depending from the insert into the aperture of the base to perform a number of important functions, the new Lamson insert did not have ribs. Instead, the new insert was designed so that the insert itself flexes down "within the aperture" when installed to perform the very same functions the ribs performed in Lamson's original infringing product.

The Intermatic II District Court Proceedings. Intermatic filed suit against Lamson for its continued infringement of the Berlin patent on December 9, 1999 ("*Intermatic II*"). Lamson moved for summary judgment of non-infringement on March 7, 2000. Lamson's motion did not dispute that its new insert was equivalent to the claimed insert, or that the new insert had structure within the aperture when the insert is installed. Rather, Lamson argued that infringement under the doctrine of equivalents was barred by several alleged estoppels. The district court granted Lamson's motion with respect to claims 1 and 3-12, finding that the amendment to claim 14 created an estoppel with respect to claims 1 and 3-12. Intermatic appealed to the Federal Circuit.

5. The Appeals To The Federal Circuit

The appellate briefing in *Intermatic I* was finished on August 18, 2000 and the appellate briefing in *Intermatic II* was finished on April 16, 2001. *Intermatic I* and *II* were separately argued in front of the same three-member panel of the Federal Circuit on September 4, 2001.

On December 17, 2001, in a 2-1 decision, the Federal Circuit reversed the jury verdict of infringement under the doctrine of equivalents in *Intermatic I* for the following reasons:

> When an amendment narrows the scope of a claim for a reason relating to patentability, no range of equivalents is available for that amended claim limitation. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 569, 576, 56 USPQ2d 1865, 1872, 1878 (Fed. Cir. 2000) (en banc), *cert. granted*, __ U.S. __ (2001) (No. 00-1543). Accordingly, because the "insert within the aperture" limitation in reexamined claim 14 was added for a reason relating to patentability, *i.e.*, to avoid the prior art, Intermatic is barred from obtaining any range of equivalents for that limitation.
>
> Furthermore, that equivalence bar extends to all of the claims in which the "insert within the aperture" limitation appears.
>
> . . . .We conclude that the principles espoused in *Builders* [*Builders Concrete, Inc. v. Bremerton Concrete Products Co.*, 757 F.2d 255, 225 USPQ 240 (Fed. Cir. 1985)] equally apply to a claim limitation that was narrowed in order to obtain allowance of a claim during reexamination, despite the fact that the resulting estoppel may retroactively extend to original, unamended claims, and hold that any estoppel generated by such an amendment applies

> to all other claims in the patent containing that limitation.

(App. 17a-19a). The Federal Circuit affirmed the summary judgment of non-infringement in *Intermatic II* because "as discussed above, Intermatic is not entitled to any range of equivalents with respect to the 'within the aperture' limitation." (App. 20a-21a).

REASONS FOR GRANTING THE WRIT

I. THE DECISION BELOW IS CONTRARY TO THIS COURT'S RECENT *FESTO* DECISION

The Federal Circuit applied a complete bar to refuse Intermatic access to the doctrine of equivalents (App. 17a-19a). After noting a narrowing amendment to claim 14, the Federal Circuit applied the complete bar to each of the asserted claims without examining the subject matter surrendered by the amendment, and vacated the doctrine of equivalents jury verdict. As such, the decision below is in direct conflict with this Court's recent *Festo* decision, No. 00-1543 (May 28, 2002).

In that decision this Court rejected the Federal Circuit's complete bar rule, and held that prosecution history estoppel "requires an examination of the subject matter surrendered by the narrowing amendment." *Festo*, 122 S. Ct. at 1840. Before barring access to the doctrine of equivalents a court must determine whether the patent owner "can demonstrate that the narrowing amendment[] did not surrender the particular equivalents at issue." *Id.* at 1842. The Federal Circuit did not make that determination in this case. Had it done so the Federal Circuit would have concluded that Intermatic did not surrender the particular equivalents at

issue because asserted claims were already allowed at the time of the narrowing amendment to claim 14. Accordingly, the decision below is contrary to this Court's *Festo* decision. By this petition, Intermatic seeks remand to the Federal Circuit for further proceedings consistent with this Court's *Festo* decision, No. 00-1543 (May 28, 2002). S. Ct. Rule 16.1 (permitting summary disposition on the merits).

II. THE DECISION BELOW IS BASED ON THE FEDERAL CIRCUIT'S NOW OVERRULED *FESTO* DECISION

The decision below specifically relied on the Federal Circuit's now overruled *Festo* decision and the complete bar rule created therein. Because *Festo* and the complete bar rule are no longer good law, this case should be remanded to the Federal Circuit for proceedings consistent with this Court's *Festo* decision. This already has happened in several other cases affected by *Festo*, and the same should occur here. *See, e.g., Mycogen Plant Science, Inc. v. Monsanto Co.*, No. 01-740, 2002 WL 1159483 (June 3, 2002); *Insituform Technologies, Inc. v. CAT Contracting, Inc.*, No. 00-1946, 2002 WL 1159441 (June 3, 2002) ; *Creo Products, Inc. v. Dainippon Screen Mfg. Co., Ltd.*, No. 01-269, 2002 WL 1159456 (June 3, 2002); *Semitool, Inc. v. Novellus Systems, Inc.*, No. 01-423, 2002 WL 1159458 (June 3, 2002); *Lockheed Martin Corp. v. Space System/Loral, Inc.*, No. 01-506, 2002 WL 1159498 (June 3, 2002); *PTI Technologies, Inc. v. Pall Corp. Technologies, Inc.*, No. 01-677, 2002 WL 1159474 (June 3, 2002). To do otherwise subjects Intermatic to disparate treatment under the law.

CONCLUSION

The petition for a writ of certiorari should be granted, and the decision below should be vacated and remanded to the Federal Circuit.

Respectfully submitted,

JOHN K. LUCAS
(*Counsel of Record*)
HAROLD V. JOHNSON
TIMOTHY Q. DELANEY
MARK H. REMUS
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, Illinois 60611
(312) 321-4200

Counsel for Petitioner,
INTERMATIC
INCORPORATED

PETITIONER'S APPENDIX

United States Court of Appeals,
Federal Circuit.

INTERMATIC INCORPORATED, Plaintiff-Cross Appellant,
v.
The LAMSON & SESSIONS CO., Defendant-Appellant.
Intermatic Incorporated, Plaintiff-Appellant,
v.
Lamson & Sessions Co., Defendant-Appellee.

Nos. 00-1101, 00-1116 and 01-1028.

DECIDED: Dec. 17, 2001.
Rehearing En Banc Denied Feb. 6, 2002.

Before NEWMAN, LOURIE, and RADER, Circuit Judges.

Opinion for the court filed by Circuit Judge LOURIE. Circuit Judge PAULINE NEWMAN concurs in the judgment and dissents-in-part.

LOURIE, Circuit Judge.

The Lamson & Sessions Co. appeals from the decision of the United States District Court for the Northern District of Illinois: (1) denying its combined motion for judgment as a matter of law and for a new trial following a jury verdict in favor of Intermatic Incorporated that determined that certain Lamson outdoor electrical outlet covers infringed Intermatic's U.S. Patent 5,280,135; and (2) granting Intermatic's motion for judgment as a matter of law that claims 6, 9, and 11 are not invalid for obviousness. *Intermatic Inc. v. Lamson & Sessions Co.*, No

94-C-50295 (N.D. Ill. Oct. 20, 1999) ("*Intermatic I*"). Intermatic cross-appeals the district court's exclusion of certain evidence it proffered in support of future damages and the court's denial of enhanced damages and attorney fees. Intermatic also appeals from a separate decision of the district court in a second infringement lawsuit it filed against Lamson, which granted summary judgment of noninfringement of the '135 patent with respect to a separate line of Lamson outlet covers. *Intermatic Inc. v. Lamson & Sessions Co.*, No. 99-C-50410, 2000 WL 1470393 (N.D. Ill. Sept. 28, 2000) ("*Intermatic II*"). For the reasons set forth below, we affirm-in-part and reverse-in-part the decision of the district court in *Intermatic I*, and affirm in all respects its decision in *Intermatic II*.

BACKGROUND

Intermatic's '135 patent is directed to a weatherproof electrical outlet cover. Typical weatherproof outlet covers provide outdoor electrical outlets with ample protection from "the elements" when the outlet has a cord from an electrical appliance plugged into one of its receptacles. '135 patent, col. 1, ll. 20-25. However, these covers are tailor-made to fit only a specific type of electrical outlet (*e.g.*, single-gang-vertical, single-gang-horizontal, double-gang). *Id.* at ll. 41-51. The outlet cover claimed in the '135 patent similarly provides electrical outlets with protection from the weather, but at the same time is capable of accommodating various types of electrical outlets through the use of a base plate with an aperture, a removable insert, and a protective housing. *Id.* at col. 2, ll. 29-33.

The '135 patent contains nineteen claims, and all but claims 2 and 19 are at issue in this appeal. Of the three

independent claims implicated in this appeal, two limitations contained therein are at issue. Independent claim 1 reads as follows:

> 1. An outdoor weatherproof protective electrical outlet cover adapted to be attached in weatherproof connection to an electrical outlet comprising:
> (a) a base plate adapted to be attached in weatherproof connection with the electrical outlet, the base plate having an aperture of sufficient size to accommodate the electrical outlet positioned in *a first orientation and a second orientation* wherein only one electrical outlet orientation can be accommodated at a given time;
> (b) *an insert sized an [sic] adapted to fit within the aperture* of the base plate in a first orientation, the insert being of sufficient size to accommodate one electrical outlet orientation;
> (c) a protective housing defining a closed space enclosing the electrical outlet even with at least one electrical plug present, the protective housing adapted to be mounted to the base plate.

Id. at col. 8, ll. 42-59 (emphasis added). Like claim 1, independent claim 12 also requires the outlet cover to have an "insert adapted to be accommodated within the aperture of the base plate" (hereinafter, the "insert within the aperture" limitation) and a base plate having an aperture capable of accommodating an electrical outlet positioned in "a first orientation and a second orientation" (hereinafter, the "multiple orientation" limitation). *Id.* at col. 9, ll. 31-50. Claim 14, the third independent claim at issue on appeal, was altered from

its original form as the result of a reexamination proceeding initiated by Lamson during the pendency of the present lawsuit. Claim 14, with the additions and deletions resulting from the reexamination proceeding indicated by underlining and brackets, respectively, reads as follows:

> 14. A weather resistant outlet cover for a [*sic*] electrical service device mounted in an electrical box comprising:
> a base adapted to be mounted in a moisture resistant connection around the electrical box, *said base having an aperture* therein;
> a housing pivotally connected to the base along an upper portion thereof and adapted to provide a moisture resistant enclosure in front of the electrical device; and
> an insert adapted to be [mounted] *accommodated with* [*sic*] *the aperture* in the base and further in which the insert includes at least an aperture therein conforming in size and shape to the electrical service device.

U.S. Patent B1 5,280,135, col. 2, ll. 4-16. Thus, claim 14 also contains the "insert" limitation,[1] but does not contain the "multiple orientation" limitation.

Figure 4 illustrates a typical outlet cover as claimed in the '135 patent:

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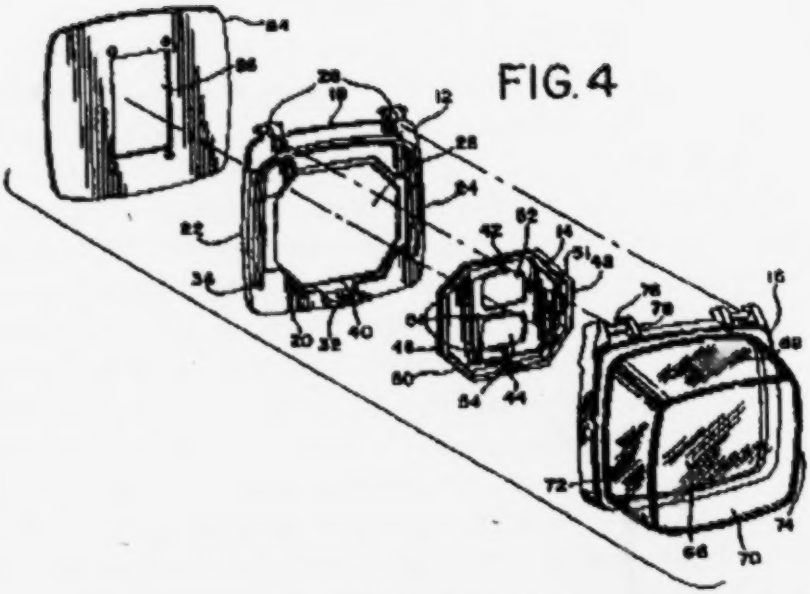
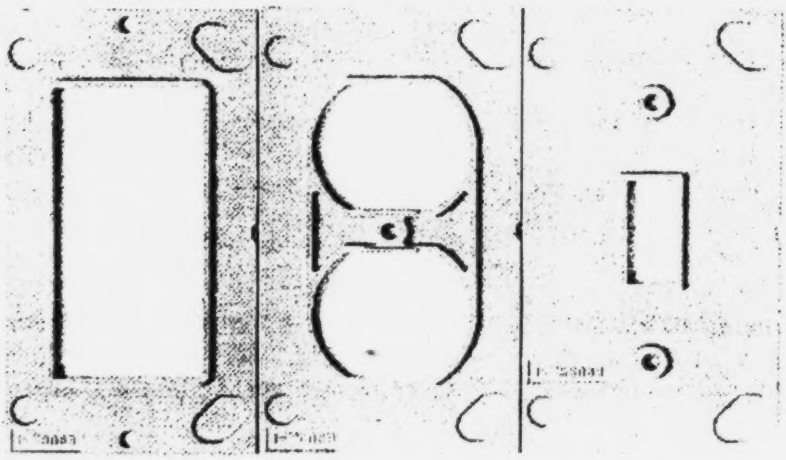
[1] Although each claim utilizes different language to express the "insert within the aperture" limitation, neither party has argued that any appreciable difference exists between the language used to express that limitation in the claims at issue. We therefore interpret the "insert within the aperture" limitation identically in all of the relevant claims.

FIG. 4



The outlet cover 10 is comprised of a base plate 12 that is mounted over the electrical outlet to be protected, wherein the base plate 12 has an aperture 26 that is large enough to encompass the plurality of styles and orientations of the plug receptacles in various electrical outlets. '135 patent, col. 2, ll. 22-26, col. 3, ll. 26-28. The insert 14 is then fitted within the aperture 26 of the base plate 12 in a flush manner to provide, in cooperation with the flange 50 and the raised ledge 51, a secure connection that protects the outlet from a variety of weather conditions. *Id.* at col. 4, ll. 5-15. The insert 14 may be placed in a variety of orientations depending on the type of electrical outlet to be protected. *Id.* at col. 2, ll. 29-33. The protective housing 16 is mounted over the base plate 12 to define a closed space of sufficient size to envelop an electrical outlet with at least one plug engaged in a plug receptacle of that outlet. *Id.* at ll. 35-39.

Lamson manufactures a number of weatherproof electrical outlet covers, each of which utilizes a base plate, a protective housing, and either one or two inserts, depending on the type of electrical outlet to be protected. *Intermatic Inc. v. Lamson & Sessions Co.*, No 94-C-50295, slip op. at 3, 1999 WL 181977 (N.D. Ill. Mar. 30, 1999) (order). However, Lamson's outlet covers differ from the outlet cover claimed in the '135 patent in two respects that form the heart of the present infringement dispute. First, the inserts of Lamson's outlet covers do not fit within the aperture of the base plate. *Id.* Rather, each insert contains "ribs" that outline the general configuration of the outlet receptacles it is intended to cover, wherein the ribs extend into the aperture from the rear wall of the insert. *Id.* No other portion of the insert extends into the aperture. Second, all of Lamson's covers are designed to be used with either horizontally oriented outlets or vertically oriented outlets, but a single outlet cover is not capable of accommodating both types of outlets. The following photograph illustrates a number of Lamson's "ribbed" inserts:



Intermatic filed suit against Lamson alleging that the following Lamson products infringed the '135 patent: (1) Lamson's E9UV(G,W,C) vertical single-gang outlet cover; (2) Lamson's E9UDV(G,W,C) deep vertical single-gang outlet cover; (3) Lamson's E9U2(G,W,C) double-gang outlet cover;[2] and (4) Lamson's E9UH(G,W,C) horizontal single-gang outlet cover (hereinafter, the "ribbed products"). *Id.* at 2-3. The district court construed the "insert within the aperture" limitation to require that the insert "have an outer dimension conforming to or smaller than the outer dimension of the aperture, and does not include the flange and the raised ledge so as to fit 'within the aperture.' " *Intermatic Inc. v. Lamson & Sessions Co.*, No 94-C- 50295, 1999 WL 102767, at *2 (N.D. Ill. Feb. 9, 1999) (order). The district court also construed the "multiple orientation" limitation to include not only base plates with apertures large enough to accommodate both horizontally and vertically oriented electrical outlets with a single insert, but also those able to accommodate orientations 180 degrees apart from one another. *Id.* at *1. In light of its claim construction, the court granted Lamson's motion for summary judgment that the ribbed products did not literally infringe the '135 patent, but denied Lamson's motion as to infringement under the doctrine of equivalents. *Intermatic Inc. v. Lamson & Sessions Co.*, No 94-C-50295, 1999 WL 181977, at *5 (N.D. Ill. Mar. 30, 1999) (order). Thereafter, the jury found that Lamson's ribbed products infringed claims 1, 3, 4, 6-9, and 11 18 under the doctrine of equivalents, and found dependent claims 6, 9, and 11 invalid for obviousness. *Intermatic I.*

During the damages phase of the trial, the district court

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[2] This product number refers to both the original and redesigned double-gang outlet cover, both of which are accused of infringing the '135 patent.

refused to allow Lamson to introduce evidence of its recently redesigned line of outlet covers utilizing inserts not having a ribbed portion (hereinafter, the "ribless products") in order to demonstrate the existence of noninfringing substitutes. *Intermatic Inc. v. Lamson & Sessions Co.*, No 94-C-50295 (N.D. Ill. Aug. 27, 1999) (order). The court also refused to allow Intermatic to present certain evidence concerning the amount of future damages it will incur as a result of Lamson's infringement. *Intermatic Inc. v. Lamson & Sessions Co.*, No 94-C-50295 (N.D. Ill. Sept. 20, 1999) (order). The jury found that Lamson willfully infringed the '135 patent by selling its ribbed products, and awarded Intermatic damages for lost profits and price erosion in the amount of $12,500,000. *Intermatic I.*

Both parties filed multiple post-trial motions. Lamson filed a combined motion for JMOL or for a new trial on the grounds that, *inter alia:* (1) independent claims 1 and 12 must be found to have been obvious in view of the jury's finding that dependent claims 6, 9, and 11 were obvious; (2) Intermatic's equivalence evidence was legally insufficient and that, in any event, its equivalence claim was barred by prosecution history estoppel; (3) Intermatic was not entitled to lost profits; and (4) the district court erroneously excluded evidence of Lamson's ribless products. Intermatic filed post-trial motions seeking, *inter alia:* (1) enhanced damages; (2) attorney fees; and (3) JMOL that dependent claims 6, 9, and 11 would not have been obvious over the prior art in light of the jury's answers to special interrogatories that formed the basis for its nonobviousness verdict with respect to claims 1 and 12. The district court denied Lamson's combined motion for JMOL and for a new trial in all respects, but granted Intermatic's motion for JMOL that claims 6, 9, and 11 are not invalid for obviousness. *Id.*

Shortly after the district court entered judgment in *Intermatic I*, Intermatic filed suit against Lamson alleging that Lamson's ribless products, the very same products excluded from trial in *Intermatic I*, infringed the '135 patent. *Intermatic II* at *1. The district court granted Lamson's motion for summary judgment of noninfringement because it determined that, under its construction of the "insert within the aperture" limitation in *Intermatic I*, Lamson did not literally infringe as a matter of law, and prosecution history estoppel barred a finding of infringement under the doctrine of equivalents. *Id.* at *1-*2.

Lamson appeals from the district court's denial of its motion for JMOL of noninfringement, as well as from the court's grant of Intermatic's motion for JMOL that claims 6, 9, and 11 are not invalid for obviousness, in *Intermatic I*. Intermatic cross-appeals the court's exclusion of its future damages evidence and denial of enhanced damages and attorney fees in *Intermatic I*. Intermatic also appeals from the district court's grant of summary judgment of noninfringement in *Intermatic II*. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

DISCUSSION

Summary judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c). "The evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in his favor." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). We

review a district court's grant of a motion for summary judgment *de novo*. *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1315, 47 USPQ2d 1272, 1275 (Fed. Cir. 1998).

Judgment as a matter of law ("JMOL") is appropriate when "a party has been fully heard on an issue and there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue." Fed.R.Civ.P. 50(a)(1). We review a district court's grant or denial of a motion for JMOL *de novo*, reapplying the JMOL standard used by the district court. *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 824, 49 USPQ2d 1865, 1869 (Fed. Cir. 1999). To prevail, an appellant "must show that the jury's findings, presumed or express, are not supported by substantial evidence or, if they were, that the legal conclusion(s) implied from the jury's verdict cannot in law be supported by those findings." *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 893, 221 USPQ 669, 673 (Fed. Cir. 1984) (citation omitted).

A determination of infringement requires a two-step analysis. "First, the court determines the scope and meaning of the patent claims asserted ... and then the properly construed claims are compared to the allegedly infringing device." *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454, 46 USPQ2d 1169, 1172 (Fed. Cir. 1998) (en banc) (citations omitted). Literal infringement requires that every limitation of the patent claim be found in the accused device. *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 821, 23 USPQ2d 1426, 1431 (Fed. Cir. 1992). "An accused device that does not literally infringe a claim may still infringe under the doctrine of equivalents if each limitation of the claim is met in the accused device either literally or equivalently." *Cybor*, 138 F.3d at 1459, 46 USPQ2d at 1177. Claim construction is an issue of law,

Markman v. Westview Instruments, Inc., 52 F.3d 967, 970-71, 34 USPQ2d 1321, 1322 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), that we review *de novo*, *Cybor*, 138 F.3d at 1456, 46 USPQ2d at 1172. Determination of infringement, whether literal or under the doctrine of equivalents, is a question of fact. *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1125, 227 USPQ 577, 589 (Fed. Cir. 1985) (en banc). Finally, the applicability of prosecution history estoppel is a legal question that we review *de novo*. *Cybor*, 138 F.3d at 1460, 46 USPQ2d at 1178.

A. *Claim Construction*

1. *The "multiple orientation" limitation*

Lamson argues that the district court erred in construing the "multiple orientation" limitation in claims 1 and 12 to cover one hundred eighty degree rotations of the insert. Lamson contends that the language of the claims and the specification make clear that the "multiple orientation" limitation requires an outlet cover that can encompass *both* horizontal and vertical electrical outlets by using a single, symmetrical insert that can be rotated ninety degrees. Intermatic responds that the plain language of the relevant claims and the specification allow one hundred eighty degree rotations of the insert to be included within the construction of the "multiple orientation" limitation. Intermatic further argues that claim 3, which depends from claim 1, claims the precise construction advocated by Lamson, and that therefore the doctrine of claim differentiation requires that the "multiple orientation" limitation not be restricted to outlet covers that accommodate both horizontal and vertical electrical outlets.

We agree with Intermatic that the district court properly construed the "multiple orientation" limitation to include one hundred eighty degree rotations of the insert. Absent an express intent to impart a novel meaning, "terms in a claim are to be given their ordinary and accustomed meaning." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998). The relevant claims at issue require that the aperture be large enough to enable the insert to fit within the aperture "in a first orientation and a second orientation." '135 patent, col. 8, ll. 48-49, col. 9, ll. 38-39. The ordinary meanings of the terms "first" and "second" do not require that the orientations be separated by any specific degree of rotation, such as the ninety degree difference argued by Lamson. Rather, such language broadly claims an outlet cover with an aperture large enough to accommodate an insert placed in *any* two orientations, whether those orientations be separated by one hundred eighty degrees, ninety degrees, or any other degree of rotation.

The specification supports this construction of the "multiple orientation" limitation. The "Summary of the Invention" states that "the insert may be fitted within the aperture of the base plate *in a plurality of orientations* in order to encompass electrical outlets of *either* a horizontal orientation or a vertical orientation." *Id.* at col. 2, ll. 30-33 (emphasis added). That language suggests that, in addition to being able to rotate the insert ninety degrees to accommodate both a vertical and horizontal outlet with the same outlet cover, the insert may be rotated one hundred eighty degrees, *i.e.*, turned upside down, to accommodate *only* a horizontally oriented outlet or *only* a vertically oriented outlet. Such a degree of rotation may be necessary, for example, to accommodate outlets in which the plug receptacles are not arranged in a

symmetrical fashion. Indeed, the examiner recognized this very use of the claimed outlet cover, stating that "[a]n insert ... could be placed in two different orientations ... each 180° apart." The ninety degree rotation construction proffered by Lamson is therefore merely a preferred embodiment of the invention. *See id.*, col. 3, ll. 49-59 ("*In this embodiment* ... the aperture and the insert are such that the insert *can* be positioned in the aperture in two separate orientations ...90° apart.").

Moreover, claim 3 of the '135 patent, which is dependent on claim 1, differs from the latter only in that the aperture must be "of sufficient size to enclose an electrical outlet positioned *in a first substantially vertical position and a second substantially horizontal position* ...." *Id.* at col. 8, ll. 65-67 (emphasis added). Under the doctrine of claim differentiation, each claim in a patent is presumptively different in scope. *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998). This presumption can be strengthened under certain circumstances. One of those circumstances was espoused in *Wenger Manufacturing, Inc. v. Coating Machinery Systems, Inc.*, wherein this court stated that "[c]laim differentiation, while often argued to be controlling when it does not apply, is clearly applicable when there is a dispute over whether a limitation found in a dependent claim should be read into an independent claim, and that limitation is the only meaningful difference between the two claims." 239 F.3d 1225, 1233, 57 USPQ2d 1679, 1685 (Fed. Cir. 2001). Because the only meaningful difference between claim 1 and claim 3 involves the potential orientations of the insert, the doctrine of claim differentiation provides additional support for not limiting the "multiple orientation" limitation to the construction proposed by Lamson. We therefore conclude that the district court

did not err in interpreting the "multiple orientation" limitation to include one hundred-eighty degree rotations of the insert.

2. *The "insert within the aperture" limitation*

Although Lamson's products were found to have satisfied the "insert within the aperture" limitation under the doctrine of equivalents, Intermatic argues that that limitation is literally met under the proper interpretation of its claims. Intermatic contends that the district court erred in its construction of the "insert within the aperture" limitation by excluding a preferred embodiment of the invention, and that the proper interpretation of that limitation is that the claimed "insert" is comprised of not only what it styles as the "insert plate," which is what the district court found to be the actual "insert," but also includes the flange and the raised ledge connected to it. Lamson responds that the court properly construed the "insert within the aperture" limitation to exclude the flange and the raised ledge because the specification teaches that those structures are separate from the claimed "insert."

We conclude that the district court properly construed the "insert within the aperture" limitation to exclude the flange and the raised ledge. When the meaning of a term used in a claim is sufficiently clear from its definition in the patent specification, that meaning shall apply. *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1387 (Fed. Cir. 1992). The specification states that

> [t]he insert **14** has a top edge **42**, a bottom edge **44** and two side walls **46** and **48**. *A flange* **50**

> *extends around the periphery of the insert.* The flange **50** is sized and adapted to fit securely within the recess **40** of the base plate **12** in order to form a connection with the base plate **12.** *A raised ledge* **51** *is located on the face of the insert* **14** around the periphery of the aperture **26** and flange **50.**

'135 patent, col. 4, ll. 5-12 (emphasis added). The specification therefore makes clear that the claimed "insert" is something separate from, but connected to, the flange and the raised ledge. Accordingly, the district court did not err in interpreting the "within the aperture" limitation to require the plate-like structure comprising the "insert," which does not include the flange and raised ledge, to fit within the aperture of the base plate.

B. *Literal Infringement*

Intermatic argues that the district court erred by granting summary judgment that the ribbed products do not literally infringe the '135 patent in *Intermatic I.* Intermatic contends that even under the district court's construction of that limitation, which we affirm in the immediately preceding section, Lamson's ribbed outlet covers literally infringe the '135 patent. Intermatic argues that the ribbed portion of Lamson's insert, which fits completely within the aperture, comprises the claimed "insert," while the remaining portion of the insert is akin to the flange and the raised ledge, which is considered separate from the "insert" under the district court's construction.

Intermatic's argument is not persuasive. To view the ribbed portion of Lamson's inserts, and only that portion, as comprising the claimed "insert" completely distorts the

way that structure is defined in the '135 patent. Although, as discussed above, the specification explains that the "insert" is separate from the flange and the raised ledge, that passage cannot be read to support the view that anything within the aperture of the base plate is the "insert," while anything outside of the aperture is analogous to the flange and the raised ledge. If that were the case, then *any* structure having any portion within the aperture would satisfy the "insert within the aperture" limitation. The specification makes clear that the "insert" is the plate-like structure that serves to fill the void between the aperture in the base plate and the electrical outlet being protected. *See id.* at col. 3, ll. 59-62. We therefore reject this strained application of that limitation to the accused device, and conclude that the district court did not err in granting summary judgment that Lamson's ribbed products do not literally infringe the '135 patent as a matter of law.

C. *Infringement under the Doctrine of Equivalents*

1. *Lamson's ribbed outlet covers*

Lamson argues that the district court erred by allowing the jury to determine whether its ribbed weatherproof outlet covers infringe the '135 patent under the doctrine of equivalents. Lamson contends that prosecution history estoppel bars Intermatic from claiming that the ribbed portion of its inserts satisfies the "insert within the aperture" limitation.

Intermatic responds that substantial evidence supports the jury's finding of equivalence. Intermatic argues that it demonstrated at trial that the ribs in Lamson's inserts serve the same mounting and weatherproofing functions as the "insert within the aperture" limitation, and that the

ribs achieve the same weatherproofing result in substantially the same way. Intermatic also argues that prosecution history estoppel does not bar its assertion of equivalence, and that, in any event, any applicable estoppel is limited to reexamined claim 14.

Claim 14, as originally filed, required that the "insert [be] adapted to be mounted in the base...." *Id.* at col. 10, l. 11. That claim, as was the case with the remainder of the claims of the '135 patent, was not amended during the initial prosecution and issued in substantially the same form set forth above. During reexamination, however, the examiner rejected that claim because he determined that certain prior art references read on the "mounted in the base" phrase. In response, Intermatic amended claim 14 to require that the insert be "adapted to be accommodated with[in] the aperture in the base," and argued that the claim as amended was patentable over the prior art. Thereafter, the examiner determined that claim 14 was in condition for allowance, and the United States Patent and Trademark Office issued a reexamination certificate containing the amendment. U.S. Patent B1 5,280,135, col. 2, ll. 4-16.

When an amendment narrows the scope of a claim for a reason relating to patentability, no range of equivalents is available for that amended claim limitation. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 569, 576, 56 USPQ2d 1865, 1872, 1878 (Fed. Cir. 2000) (en banc), *cert. granted*, --- U.S. ---, 121 S.Ct. 2519, 150 L.Ed.2d 692 (2001) (No. 00-1543). Accordingly, because the "insert within the aperture" limitation in reexamined claim 14 was added for a reason relating to patentability, *i.e.*, to avoid the prior art, Intermatic is barred from obtaining any range of equivalents for that limitation.

Furthermore, that equivalence bar extends to all of the claims in which the "insert within the aperture" limitation appears. In *Builders Concrete, Inc. v. Bremerton Concrete Products Co.*, this court addressed the question whether prosecution history estoppel applies to a claim containing a limitation that was added to another, separate claim to avoid prior art, where that limitation appeared in the claim in its original form and was not amended during prosecution. 757 F.2d 255, 225 USPQ 240 (Fed. Cir. 1985). In *Builders*, a "passage" limitation was incorporated into independent claim 1 from dependent claim 2 during prosecution to avoid a prior art rejection. *Id.* at 259, 225 USPQ at 243. Claim 10, a separate independent claim, also contained the "passage" limitation as originally filed, and thus did not require any amendment to place that claim in condition for allowance. *Id.* In addressing whether the estoppel resulting from the amendment to claim 1 also applied to claim 10, the court stated:

> Although claim 10 is the only claim in suit, the prosecution history of all claims is not insulated from review in connection with determining the fair scope of claim 10. To hold otherwise would be to exalt form over substance and distort the logic of this jurisprudence, which serves as an effective and useful guide to the understanding of patent claims. The fact that the "passage" clause of patent claim 10 was not itself amended during prosecution does not mean that it can be extended by the doctrine of equivalents to cover the precise subject matter that was relinquished in order to obtain allowance of claim 1.

Id. at 260, 225 USPQ at 243. Thus, the court in *Builders* held that prosecution history estoppel barred the patentee in that case from asserting equivalence between

the accused structure and claim 10 of its patent as a result of the addition of the same "passage" limitation in claim 1 to avoid the prior art. *Id.*

We conclude that the principles espoused in *Builders* equally apply to a claim limitation that was narrowed in order to obtain allowance of a claim during reexamination, despite the fact that the resulting estoppel may retroactively extend to original, unamended claims, and hold that any estoppel generated by such an amendment applies to all other claims in the patent containing that limitation. To conclude otherwise would be "to exalt form over substance," *id.*, and subject a limitation to multiple ranges of equivalence depending upon whether or not that limitation was amended in any particular claim, *see Am. Permahedge, Inc. v. Barcana, Inc.*, 105 F.3d 1441, 1446, 41 USPQ2d 1614, 1618 (Fed. Cir. 1997) ("[W]e see no reason to assign different ranges of equivalents for the identical term used in different claims in the same patent, absent an unmistakable indication to the contrary."). Moreover, arguments made to distinguish prior art during reexamination proceedings are retroactively applied to limit the scope of a claim limitation as of the issue date of the patent, not the date those arguments were made. *See, e.g., Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 532, 41 USPQ2d 1001, 1007 (Fed. Cir. 1997) (interpreting broader scope of means-plus-function limitation to have been disclaimed by arguments made by patentee to distinguish the prior art in two reexamination proceedings). For purposes of prosecution history estoppel, we see no reason to treat amendments made during reexamination differently. We therefore reject Intermatic's assertion at oral argument that the timing of a narrowing amendment dictates the applicability of prosecution history estoppel, and conclude that none of the claims at issue are entitled

to any range of equivalents regarding the "insert within the aperture" limitation under the law set forth in *Festo*.[3]

As we have already determined in section B, *supra*, that Lamson's ribbed products do not literally satisfy the "insert within the aperture" limitation, our conclusion that no equivalence can be found means that those products cannot infringe the '135 patent as a matter of law. Accordingly, we conclude that the district court erred in denying Lamson's motion for JMOL of noninfringement.

Because we have determined that Lamson's ribbed products do not meet the "insert within the aperture" limitation, we need not address whether those products satisfy the "multiple orientation" limitation.

2. *Lamson's ribless outlet covers*

Intermatic does not argue that Lamson's ribless outlet covers literally infringe the '135 patent. Furthermore, as discussed above, Intermatic is not entitled to any range of equivalents with respect to the "within the aperture" limitation. The district court therefore did not err in

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[3] We note that the dissent-in-part, while agreeing that under *Builders* the estoppel created by an amendment of a limitation applies to all unamended claims containing that same limitation, argues that the unamended claim is nevertheless entitled to a range of equivalence for that limitation for subject matter not relinquished by the amendment. The dissent-in-part thus contends that any claim in which that limitation was amended is subject to the absolute bar rule of *Festo*, but that any claim containing that very same limitation in unamended form is analyzed under the flexible bar approach rejected in *Festo*. We fail to see a basis for that distinction.

granting summary judgment in *Intermatic II* that Lamson's ribless outlet covers do not infringe the '135 patent.

D. *Invalidity*

Although we have determined that none of Lamson's products infringe the '135 patent, Lamson has asserted a counterclaim of invalidity in the form of a request for a declaratory judgment. Our determination of noninfringement does not make Lamson's counterclaim moot, *see Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 96, 113 S.Ct. 1967, 124 L.Ed.2d 1, 26 USPQ2d 1721, 1727 (1993) (holding that a finding of noninfringement does not moot a counterclaim seeking a declaratory judgment of invalidity), and we therefore must address the inconsistent obviousness verdicts issue. The issue of inconsistent verdicts is a procedural issue that is not unique to patent law. Thus, this court applies the law of the regional circuit, in this case the Seventh Circuit, to the issue of inconsistent verdicts. *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1325, 58 USPQ2d 1030, 1037 (Fed. Cir. 2001).

The jury provided answers to twenty-three special interrogatories directed to the obviousness *vel non* of the disputed claims of the '135 patent. *Intermatic Inc. v. Lamson & Sessions Co.*, No 94-C-50295 (N.D. Ill. Oct. 20, 1999) (order). After answering the interrogatories, the jury found all of the independent claims to be not invalid for obviousness; however, the jury did find dependent claims 6, 9, and 11 to be invalid. *Id.* Thereafter, upon Intermatic's motion for JMOL, the district court determined that the jury's findings with respect to claims 6, 9, and 11 conflicted with their findings regarding the independent claims and their special interrogatory

answers, and granted JMOL that claims 6, 9, and 11 are not invalid for obviousness. *Id.*

Lamson argues, citing *Stone v. City of Chicago*, 738 F.2d 896 (7th Cir. 1984), that because the jury verdicts are incompatible, and that because there was ample evidence suggesting that all of the claims of the '135 patent are invalid for obviousness, the district court erred by failing to order a new trial. Intermatic responds that the district court correctly used the jury's special interrogatory answers to resolve the conflict between the verdicts under Federal Rule of Civil Procedure 49(b), and that the court properly confirmed the validity of all of the claims of the '135 patent as a matter of law.

The rule set forth in *Stone* is inapplicable to the case at hand, as that rule is only implicated where verdicts are "logically incompatible" to the extent that they cannot be reconciled by reference to the evidence supporting them. *Stone*, 738 F.2d at 899. Rule 49(b), on the other hand, deals, *inter alia*, with the situation in which two general verdicts are inconsistent with one another, but the differences between them can be resolved by referring to the jury's answers to the special interrogatories underlying those verdicts. Rule 49(b) provides in relevant part that:

> When the [interrogatory] answers are consistent with each other but one or more is inconsistent with the general verdict, judgment may be entered pursuant to Rule 58 in accordance with the answers, notwithstanding the general verdict, or the court may return the jury for further consideration of its answers and verdict or may order a new trial.

Fed.R.Civ.P. 49(b). Thus, the district court has three options when faced with an inconsistent general verdict based on consistent special interrogatory answers. The court may: (1) order the jury to consider its answers further; (2) order a new trial; or (3) harmonize the verdict with the answers. *Campbell v. Ingersoll Milling Mach. Co.*, 893 F.2d 925, 930 (7th Cir. 1990). In the case at hand, the jury's answers overwhelmingly indicate that the prior art does not disclose an insert "within the aperture," as required by independent claims 1, 12, and 14. Therefore, because dependent claims 6, 9, and 11 each contain the "insert within the aperture" limitation, in addition to other limitations that further differentiate those claims from their respective independent claims, *see* 35 U.S.C. § 112, ¶ 4 (1994), it follows *a fortiori* that those claims are also not invalid over the cited prior art, *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987). Accordingly, we conclude that the district court did not err in granting JMOL that neither dependent claims 6, 9, and 11 nor any of the remaining disputed claims of the '135 patent are invalid for obviousness.

Because we reverse on infringement, the remaining issues concerning the exclusion of evidence, damages, and attorney fees are moot.

CONCLUSION

The district court erred in denying Lamson's motion for JMOL of noninfringement of the ribbed products in *Intermatic I*. However, the court correctly granted Intermatic's motion for JMOL that claims 6, 9, and 11 of the '135 patent are not invalid for obviousness. Finally, the district court properly granted summary judgment of noninfringement of the ribless products in *Intermatic II*.

Accordingly, with respect to *Intermatic I*, we

AFFIRM-IN-PART and *REVERSE-IN-PART*.

As to *Intermatic II*, we

AFFIRM.

PAULINE NEWMAN, Circuit Judge, concurring in the judgment, dissenting in part.

On review of the facts and law of this case, I reach the same result as does the court. However, I do not endorse the new ruling that an unamended claim is barred from access to any degree of equivalency simply because a broader claim was amended during prosecution.

It has long been the law that estoppel affects the scope of equivalents available to an unamended claim, when a broader claim is amended for reasons of patentability. That was the holding in *Builders Concrete, Inc. v. Bremerton Concrete Products Co.*, 757 F.2d 255, 260, 225 USPQ 240, 243 (Fed. Cir. 1985), and reflects the traditional rules of estoppel. It is properly applied in reexamination, as the court's opinion explains. However, the court today enlarges that estoppel to enhance the absolute bar of *Festo*, even though the claim was not amended. The court thus holds that the amendment of a broader claim bars access to any scope of equivalency as to the unamended narrower claim, whether or not the accused infringer is practicing subject matter that was required to be relinquished. In *Festo* this court did not go so far; I see no need to do so in order to respect the principles of *Festo*.

Festo does not prevent an unamended claim from serving as a source of equivalency, subject to estoppel against recovering by equivalency the subject matter that was relinquished in order to achieve patentability of a different claim. This decision, by extending the *Festo* absolute bar to such unamended claims, will give the coup de grace to this vestige of the doctrine of equivalents. The consequences for patent prosecution, with its traditional presentation of claims of diminishing scope, have not been explored by the parties or by the court. I respectfully dissent from the majority's ruling on this aspect.

United States Court of Appeals for the Federal Circuit

00-1101, -1116

INTERMATIC INCORPORATED

Plaintiff-Cross Appellant,

v.

THE LAMSON & SESSIONS CO.,

Defendant-Appellant.

01-1028

INTERMATIC INCORPORATED,

Plaintiff-Appellant,

v.

LAMSON & SESSIONS CO.,

Defendant-Appellee.

ORDER

A petition for rehearing en banc having been filed by Intermatic Incorporated, and the matter having first been referred as a petition for rehearing to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the Court will issue on February 13, 2002.

FOR THE COURT,

/s/
Jan Horbaly
Clerk

Dated: February 6, 2002

Supreme Court, U.S.
FILED

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OFFICE OF THE CLERK

NO. 01-

IN THE

Supreme Court Of The United States

INTERMATIC INCORPORATED,

Petitioner,

V.

THE LAMSON & SESSIONS CO.,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

SUPPLEMENTAL APPENDIX

JOHN K. LUCAS
(*Counsel of Record*)
HAROLD V. JOHNSON
TIMOTHY Q. DELANEY
MARK H. REMUS
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, Illinois 60611
(312) 321-4200
Counsel for Petitioner

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INCORPORATED,	)	
Plaintiff,	)	
	)	No. 99 C 50410
v.	)	
LAMSON & SESSIONS CO.,	)	
Defendant.	)	

MEMORANDUM OPINION AND ORDER

Introduction

Plaintiff Intermatic Inc. ("Intermatic") has filed a second suit against Lamson & Sessions Co. ("Lamson"), alleging infringement of Intermatic's U.S. Pat. 5,280,135 ("the '135 patent," which the parties also refer to as "the Bentsen patent"). This court has jurisdiction over the dispute pursuant to 28 U.S.C. § 1338, and venue is proper pursuant to 28 U.S.C. § 1400(b). Currently before the court are several motions: Intermatic's motion to dismiss Lamson's affirmative defense and counterclaim of infringement, filed pursuant to Fed.R.Civ.P. 12(b)(6); Lamson's motion for judgment on the pleadings pursuant to Rule 12(c) as to Intermatic's claim of infringement; and, Lamson's motion for summary judgment, filed pursuant to Fed.R.Civ.P. 56, as to noninfringement of the '135 patent.

Discussion

A. Intermatic's Motion to Dismiss Lamson's Validity Challenge

The parties in this lawsuit are no strangers to each other or the court, having extensively litigated the '135 patent before this court in *Intermatic v. Lamson & Sessions*, No. 94 C 50295, currently pending before the Federal Circuit Court of Appeals. In case No. 94 C 50295, on September 17, 1999, a jury confirmed the validity under 35 U.S.C. § 103 of all independent claims of the '135 patent. Although the jury found three dependent claims (claims 6, 9 and 11) were invalid, this court found as a matter of law that dependent claims 6, 9 and 11 are valid per Order dated October 20, 1999. This court further found the facts overwhelmingly supported a finding that independent claims 1, 12 and 14 are valid.

Intermatic is correct in that Lamson cannot again attack the validity of the '135 patent in this case. *See Blonder Tongue Lab Inc. v. University of Ill. Found.*, 402 U.S. 313 (1971); *Pharmacia & Upjohn Co. v. Mylan Pharm., Inc.*, 170 F.3d 1373, 1379 (Fed. Cir. 1999). Lamson had a full and fair opportunity to litigate the validity of the '135 patent in Case No. 94 C 50295. Lamson argues the preclusive effect of the prior lawsuit does not extend to invalidity defenses to claims not litigated in the prior action. (Def. Resp., p. 2) The court rejects Lamson's argument. The claims not at issue in the previous lawsuit are not at issue in this case. (Plaintiff Reply, p. 1) Thus, Lamson has no reasonable apprehension that new claims are at issue here. *See Grain Processing Corp. v. American Maize Prod. Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988). In addition, that Case No. 94 C 50295 is on appeal has no effect on the finality of the court's and jury's findings regarding the validity of the '135 patent.

Mylan, 170 F.3d at 1381; *Dana Corp. v. NOK, Inc.*, 882 F.2d 505, 507 (Fed. Cir. 1989). Thus, Intermatic's motion to dismiss Lamson's affirmative defense and counterclaim of validity is granted.

B. Lamson's Motion for Summary Judgment

Lamson argues its redesigned "ribless" product does not literally infringe on the '135 patent as a matter of law, based on the court's previous rulings in Case No. 94 C 50295. The court agrees. In that case, per Order dated March 30, 1999, the court ruled as a matter of law that Lamson's in use weatherproof outlet covers with "ribbed" inserts did not literally infringe any of the pertinent claims of the '135 patent. It stands to reason that the "ribless" product does not literally infringe the '135 patent for the same reasons.

In its March 30, 1999 Order, this court also held it was for the jury to decide whether Lamson's "ribbed" product infringed under the doctrine of equivalents. Specifically, this court stated:

> [A]t issue is whether Lamson's inserts have an element that is equivalent to Intermatic's insert 'within the aperture.' As stated above, Lamson's inserts in each of its products have a structure called 'ribs' or 'ribbing.' This ribbing extends into the aperture of the base and performs mounting and locating functions.

Intermatic v. Lamson & Sessions, No. 94 C 50295, Order dated Mar. 30, 1999, at 10.

As this passage shows, the predominant reason the 94 C 50295 case proceeded to the jury stage was because of

the ribbing on the back of Lamson's inserts which extended into the aperture. Absent such ribbing and in light of the court's interpretations of the '135 patent following the *Markman* hearing, *see* order dated Feb. 9, 1999, Lamson's "ribless" product does not infringe under the doctrine of equivalents.

Intermatic argues a question of fact exists as to whether the "ribless" product infringes because when installed, the "ribless" insert flexes into the aperture. The court rejects Intermatic's argument. It is undisputed the Examiner rejected original claim 14 of the '135 patent as obvious over Leong in view of Bentsen. (LR56.1(a) ¶ 19) Intermatic then amended claim 14 to include the limitation that the insert be "accommodated within the aperture." (*Id.* ¶ 22) As Lamson notes, the thin, flexible insert plates of Bentsen are bendable in the middle, "said inserts being free at their mid portions to bend inwardly..." Def. Reply, Exh. A, Bentsen patent, col. 4, 11. 26-35. This description shows the Bentsen insert could bow into the aperture. Thus, in amending claim 14, Intermatic relinquished the subject matter of whether a thin, flexible insert, capable of bowing into the aperture, is an equivalent of an insert "within the aperture." In short, prosecution history estoppel precludes Intermatic's argument. *See Haynes Int'l, Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1577 78 (Fed. Cir. 1993).

C. Lamson's Rule 12(c) Motion

In light of the court's ruling regarding Lamson's motion for summary judgment, its Rule 12 (c) motion is denied as moot.

Conclusion

For the reasons set forth above, Intermatic's motion to dismiss Lamson's validity challenge is granted, Lamson's motion for summary judgment is granted, and Lamson's Rule 12(c) motion is denied as moot. This cause is hereby dismissed in its entirety.

ENTER:

/s/
PHILIP G. REINHARD, JUDGE
UNITED STATES DISTRICT COURT

DATED: September 28, 2000

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	No. 94 C 50295
	)	
LAMSON & SESSIONS CO.,	)	
	)	
Defendant.	)	

JUDGMENT IN A CIVIL CASE

Jury Verdict. This action came before the Court for a trial jury. The issues have been tried and the jury rendered its verdict.

Decision by Court. This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS HEREBY ORDERED AND ADJUDGED that plaintiff, Intermatic, Inc's, motion for judgment as a matter of law that Lamson does not infringe claim 19 is granted. The court enters judgment in favor of Lamson & Sessions Company and against Intermatic, Inc. only to the extent that Lamson & Sessions Company does not infringe claim 19. Plaintiff's oral motion for judgment as a matter of law on validity defense is denied. (See minute order of September 16, 1999.)

As to validity, the court enters judgment in favor of plaintiff, Intermatic, Inc., on claims 1, 4, 5, 8, 10, 12, 14, 15, and 18 and against defendant, Lamson & Sessions Company, and the court enters judgment in favor of defendant, Lamson & Sessions Company, on claims 6, 9, and 11 and against plaintiff, Intermatic, Inc. As to infringement on the original double gang outlet covers made by Lamson, the court enters judgment in favor of plaintiff, Intermatic, Inc., on claims 1, 3, 4, 6, 7, 8, 9, 11, 12, 14, 15, 16, 17, and 18 and against defendant, Lamson & Sessions Company, and the court enters judgment in favor of defendant, Lamson & Sessions Company, on claims 5 and 16 and against plaintiff, Intermatic Inc. As to infringement on the redesigned double gang outlet covers made by Lamson, the court enters judgment in favor of plaintiff, Intermatic, Inc., on claims 1, 3, 4, 6, 7, 8, 9, 10, 11, 12, 14, 15, 17, and 18 and against defendant, Lamson & Sessions Company, and the court enters judgment in favor of defendant, Lamson & Sessions Company, on claims 5 and 16 and against plaintiff, Intermatic, Inc. As to infringement on the single gang outlet covers made by Lamson, the court enters judgment in favor of plaintiff, Intermatic, Inc., on claims 1, 4, 5, 6, 8, 9, 10, 11, 12, 14, 15, and 18 and against defendant, Lamson & Sessions. (See minute order of September 17, 1999.)

The court enters judgment as to damages for lost profits and price erosion in favor of plaintiff, Intermatic, Inc. and against defendant, Lamson & Sessions, Co., in the amount of $12,500,000.00 and jury verdict finding defendant, Lamson & Sessions, Co.'s, infringement was willful. (See minute order of September 22, 1999.)

Plaintiff's motion for prejudgment interest, enhanced damages and attorney fees is granted in part and denied in

part. The court awards prejudgment interest at the statutory rate of 5 percent beginning September 9, 1994 through October 20, 1999. Thereafter, Intermatic is entitled to post judgment interest at the United States Treasury bill rate compounded. The court denies plaintiff's motion for enhanced damages and attorney fees. (See minute order of October 20, 1999.)

Plaintiff's motion for judgment as a matter of law that claims 6, 9, and 11 are not invalid is granted and defendant's combined motion for judgment as a matter of law and for a new trial is denied in its entirety. Judgment is entered for Intermatic on the jury verdict of infringement and the court enters judgment for Intermatic on validity. (See minute order of October 20, 1999.)

All orders in this case are now final and appealable.

Michael W. Dobbins
Clerk of the Court

Dated: 10/20/1999

_____
Susan Wessman, Deputy Clerk

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INCORPORATED, Plaintiff, v. LAMSON & SESSIONS CO., Defendant.	No. 94-C-50295 Judge Philip G. Reinhard Magistrate Judge P. Michael Mahoney

For the reasons stated on the reverse, Lamson's second motion in limine, to exclude opinion testimony of lost profits based on alleged diminished business value, is granted.

Date: 9/20/99 /s/ (Philip G. Reinhard)

ORDER

Under Federal Rule of Evidence 702, the court has a gatekeeping function, that of ensuring an expert's testimony rests on a reliable foundation and is relevant to the task at hand. *Kumho Tire Co., Ltd. v. Carmichael*, - U.S. , 119 S. Ct. 1167, 1171 (1999); *Daubert v. Merrell Dow Pharm.*, 509 U.S. 579 (1993). In exercising its gate-keeping function, the court considers the following factors: whether the theory can be (and has been) tested; whether it has been

subjected to peer review and publication; whether there is a high known or potential rate of error and whether there are standards controlling the theory; and, whether the theory enjoys general acceptance in the relevant community. *Kumho Tire*, 119 S. Ct. at 1175. These factors do not constitute a definitive checklist, as the test of reliability is flexible. Id. at 1171.

Here, the court does not doubt the qualifications of Intermatic's expert, Paul Duggan. Nor does the court question the validity of using a price/earnings (P/E) ratio in valuing a company, or that a company's diminished business value can be a form of damages under certain circumstances. However, the court finds Intermatic has not established that Duggan's theory regarding Intermatic's alleged diminished business value rests on a reliable foundation. In calculating Intermatic's alleged diminished business value, Duggan uses Lamson's P/E ratio. Plaintiff's own submissions define a P/E ratio as the relationship between the market price of the company's stock and its *net income.* (Pl. Exh. 2(B), *Guide to Business Valuations, p. 604.6)* Yet, the product at issue which allegedly caused harm to Intermatic constitutes only a small percentage of each parties' sales (one percent of Lamson's and three percent of Intermatic's). Duggan has failed to establish any connection between Lamson's P/E ratio and the alleged harm one of its product lines, constituting only one percent of its sales, caused to Intermatic.

Because of this lack of connection, Duggan's theory does not meet any of the factors set forth in *Kumho Tire*. For example, Duggan's theory does not appear to hold up under testing. According to Lamson's expert, if Lamson's 1997 data were used instead of its 1996 data, Intermatic's

claim based on Duggan's theory would change to a negative $38.9 million. (Def. Exh. C, p. 26) Duggan himself refused to speculate as to the monetary amount of Intermatic's alleged diminished business value under his theory if Lamson did not have a profit in 1997. (Def. Second Mot. in Limine, p. 11) In addition, contrary to Intermatic's assertions, Duggan's theory has not been subjected to peer review and publications. The articles and book excerpts Intermatic has submitted generally discuss P/E ratios and diminished business value as a form of damages, but do not discuss Duggan's particular theory using these concepts applied to the facts here. Although Duggan asserts he provided similar testimony in *Flint Ink Corp. v. Brower* (E.D. Mich.), he has not provided the court with his testimony, nor is there any published opinion discussing the admissibility of his testimony. Moreover, the court has not located any other case in which an expert has asserted a damages theory similar to Duggan's in a similar contest. In short, an analysis of the general guidelines set forth in *Kumho Tire* shows Duggan's theory regarding damages in the form of Intermatic's alleged diminished business value based on Lamson's P/E ratio is inadmissible. Likewise, if Duggan's discounted future cash flow approach also depends on an inverse of Lamson's P/E ratio (Duggan's declaration is not clear on this point), it would be inadmissible for the same reasons.

Because Duggan's testimony does not meet the standard for admissibility under Rule 702, Intermatic's suggested alternatives of reserving future damages for the court, treating the jury's damages verdict as advisory, or reducing the jury's verdict are unacceptable.

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INCORPORATED, Plaintiff, v. LAMSON & SESSIONS CO., Defendant.	Civil Action No. 94-C-50295 Judge Philip G. Reinhard Magistrate Judge P. Michael Mahoney

For the reasons stated on the reverse, plaintiff Intermatic's motion in limine to preclude evidence of certain hypothetical post-trial activities is granted in part and denied in part.

Date: 8/27/99 /s/ (Philip G. Reinhard)

ORDER

This order addresses Intermatic Inc.'s ("Intermatic") motion in limine to preclude evidence of certain hypothetical post-trial activities. Specifically, Intermatic argues Lamson should be precluded from telling the jury: (1) about the possibility of an injunction; and, (2) that Lamson may sell a redesigned, non-accused product following trial.

Regarding the injunction, the court agrees with Intermatic. Whether the court awards injunctive relief (assuming Lamson is found liable) is irrelevant to any issues the jury will be deciding. *United States Football League v. National Football League*, No. 84 Civ. 7484 (PKL), 1986 U.S. Dist. Lexis 24088, at *5-7 (S.D.N.Y. June 17, 1986). Lamson argues that if Intermatic is allowed to present expert testimony regarding future lost profits and future price erosion in the form of "diminished business value," Lamson should be able to present evidence of a possible injunction. Given the court's decision to bifurcate the issues and its expressed skepticism of the admissibility of such testimony, the court reserves this issue until a later date.

Regarding Lamson's redesigned products, one of which is a "ribless" product, Lamson argues such evidence will assist the trier of fact in assessing the function of the ribs. The court disagrees. Adding a new, "ribless" product to the mix will unnecessarily confuse the jury in its task of determining what products are at issue and whether these accused products infringe. Lamson argues that allowing the jury to compare the "ribless" product with the "ribbed" product will assist the jury in understanding the function of the ribs. Lamson can accomplish this other ways.

Lamson also argues that its "ribless" product and its proposed redesigns in 1995 are relevant to the issues of willfulness and damages. It is not clear whether Intermatic is claiming that these redesigns also infringe its patent. Given that the court has bifurcated the trial, it reserves the issue of whether Lamson's '95 and '99 redesigns are admissible in the second phase of the trial and will revisit the issue at that time, if necessary.

UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INCORPORATED,	)	
Plaintiff,	)	
	)	No. 94 C 50295
v.	)	
LAMSON & SESSIONS CO.,	)	
Defendant.	)	

MEMORANDUM OPINION AND ORDER

Plaintiff Intermatic, Inc. ("Intermatic") filed suit against defendant Lamson & Sessions Co. ("Lamson"), alleging patent infringement concerning its outdoor electrical outlet covers. Jurisdiction arises under 28 U.S.C. § 1338(a), and venue is proper pursuant to 28 U.S.C. § 1400(b). Several motions are currently pending before the court. This opinion addresses Lamson's motion for summary judgment, filed pursuant to Fed.R.Civ.P. 56, on the issue of non infringement

PRELIMINARY MATTERS

Local Rule 12M and 12N statements of fact are to contain facts, not legal argument. To the extent that legal argument is contained in a party's statement of fact, or response thereto, it will be disregarded by this court. Furthermore, under Local Rules 12M and 12N, all facts and denials must be supported by specific reference to the

record. Unsupported allegations of fact will not be considered, and unsupported responses to properly supported allegations of fact will be deemed an admission of the opposing party's corresponding paragraph pursuant to Local Rules 12M and 12N.

Furthermore, Lamson has repeatedly interjected arguments and allegations concerning products not included in this infringement suit, resulting in an unnecessary clouding of the issues. As the court has yet to understand the relevance of these additional products, all such allegations and arguments related to such products will not be considered by the court.

FACTS[1]

Intermatic owns U.S. Letters Patent No. 5,280,135 (the '135 patent) directed to an outdoor electrical outlet cover. Intermatic and Lamson both manufacture weather protective/ resistant covers for outdoor electrical outlets. Following the allowance of the '135 patent application, Intermatic filed a complaint against Lamson alleging infringement of the '135 patent, asserting that four of Lamson's basic product designs infringe on Intermatic's patent: the vertical single gang - E9UV(G,W,C);[2] the deep

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[1] The facts are taken from the parties' respective statements of material fact submitted pursuant to Local Rules 12M and 12N, the *Markman* claim interpretation order (referred to hereinafter as the "*Markman* order"), and correspondence dated February 22, 1999, and February 24, 1999, from the attorneys for each party.

[2] The code "(G,W,C)" refers to the product colors gray, white and clear, respectively.

vertical single gang - E9UDV(G,W,C); the double gang - E9U2(G,W,C)[3]; and the horizontal single gang - E9UH(G,W,C). All of Lamson's allegedly infringing products have (1) a base with side walls and a back wall, (2) a housing hinged to the base, and (3) either one or two insert plates. Lamson's insert plates have structure which depends from the rear wall of the insert, referred to as "ribs" or "ribbing" by the parties.

Intermatic's patent has nineteen claims, with claims 1, 3 12, and 14 19 originally at issue in this case. During the course of litigation, the patent was reexamined, resulting in the modification of claim 14. Intermatic alleges that Lamson's electrical outlet cover infringes on three independent claims, as well as several dependent claims.[4] The currently disputed independent claims are set forth seriatim:

1. An outdoor weatherproof protective electrical outlet cover adapted to be attached in weatherproof connection to an electrical outlet comprising:

   (a) a base plate adapted to be attached in weather-proof connection with the electrical

---

[3] This product number refers to the product Lamson is currently producing. Lamson redesigned the originally named product after the onset of this litigation. It is undisputed the original double gang outlet cover was capable of horizontal and vertical positioning of the inserts.

[4] Intermatic originally alleged that Lamson's products also infringed on claim 19, but has since withdrawn this argument in light of the court's *Markman* Order.

outlet, the base plate having an aperture of sufficient size to accommodate the electrical outlet positioned in a first orientation and a second orientation wherein only one electrical outlet orientation can be accommodated at a given time;

(b) an insert sized an [sic] adapted to fit within the aperture of the base plate in a first orientation and a second orientation,. the insert being of sufficient size to accommodate one electrical outlet orientation;

(c) a protective housing defining a closed space enclosing the electrical outlet even with at least one electrical plug present, the protective housing adapted to be mounted to the base plate.

12. An improved outdoor electrical outlet cover comprising, a base plate fastened to a weather resistant electrical outlet housing adapted to cover an electrical outlet, the improvement comprising:

(a) a base plate adapted to be attached in weather-proof connection with the electrical outlet, the base plate having an aperture of sufficient size to accommodate an electrical outlet positioned in a first orientation and a second orientation wherein only one electrical outlet orientation can be accommodated at a given time;

(b) an insert adapted to be accommodated within the aperture of the base plate in a

first orientation and a second orientation, the insert being of sufficient size to accommodate one electrical outlet orientation;

(c) a protective housing defining a closed space enclosing the electrical outlet even with at least one electrical plug present, the protective housing adapted to be mounted to the base plate.

14. A weather resistant outlet cover for an electrical service device mounted in an electric box comprising:

(a) a base adapted to be mounted in a moisture resistant connection around the electrical box, *said base having an aperture therein;*

(b) a housing pivotally connected to the base along an upper portion thereof and adapted to provide a moisture resistant enclosure in front of the electrical service device; and

(c) an insert adapted to be [mounted] *accommodated with [sic] the aperture* in the base and further in which the insert includes at least an aperture therein conforming in size and shape to the electrical service device.[5]

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[5] This is reexamined claim 14. The bracketed information indicates language deleted from the original claim 14 and the italicized information indicates language which was added.

Lamson filed its motion for summary judgment of noninfringement on December 15, 1997. The motion, along with Intermatic's response, brought to light disputes between the parties in regard to claim construction. The court held a hearing on January 27, 1999, to construe disputed claim language. A summary of the court's interpretation of the disputed claim language, set forth in full in its *Markman* Order, is as follows:

(1) "Aperture" is limited to the hole in the base of the outlet cover and does not include the recess;

(2) The language "of sufficient size" does not mean "larger";

(3) The insert is defined as having an outer dimension conforming to or smaller than the outer dimensions of the aperture, and does not include the flange or raised ledge;

(4) The language "first orientation" and "second orientation" includes a 180 degree rotation of the insert;

(5) The reexamined claim 14 is substantially different than the original claim 14; and

(6) Depression of the "release button" of claim 19 is essential to opening the latching mechanism.

In response to the *Markman* Order, Intermatic withdrew allegations of infringement based on claim 19, and withdrew its arguments that the aperture includes the recess and that no substantial change was made to claim 14

during reexamination. Lamson withdrew arguments directed towards the orientation and size limitations of claims 1 and 12 with respect to its double gang units, but left intact the arguments concerning its single gang units.

STANDARD

Summary judgment is proper when no genuine issue of material fact exists and the moving party is entitled to judgment as a matter of law. *Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1378 (Fed. Cir. 1998). Justifiable factual inferences and elements of doubt are to be resolved in favor of the non movant. *Abbott Lab. v. Novopharm Ltd.*, 104 F.3d 1305, 1307 (Fed. Cir. 1997); *Trilogy Communications, Inc. v. Times Fiber Communications, Inc.*, 109 F.3d 739, 741 (Fed. Cir. 1997).

The moving party must first establish that there are no genuine issues of material fact, and the non moving party must establish specific facts showing the existence of a genuine issue of material fact. *Phillips Petroleum Co. v. Huntsman Polymers Corp.*, 157 F.3d 866, 870 (Fed. Cir. 1998). Since Intermatic has the burden of establishing infringement at trial, Lamson must show a lack of evidentiary support for Intermatic's claim. *See id.*

ANALYSIS

Any infringement analysis entails two elements. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996). The first element is the interpretation of disputed claim language, which is a question of law. *Id.* The court resolved these issues in its Markman Order. The second element is determining whether infringement has occurred. *Id.* This step involves application of the construed claims to the allegedly infringing products to

determine whether literal infringement or infringement under the doctrine of equivalents has occurred. *See, e.g., Spectrum Int'l, Inc.*, 164 F.3d at 1380.

A claim is literally infringed when every limitation recited in the claim can be found in the accused device. *Amhil Enter. Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1562 (Fed. Cir. 1996). "If even one limitation is missing or not met as claimed, there is no literal infringement." *Mas-Hamilton Grp. v. LaGard, Inc.*, 156 F.3d 1206, 1211 (Fed. Cir. 1998). Where no literal infringement is found, an accused product might still be found to be infringing under the doctrine of equivalents if it "contain[s] elements identical or equivalent to each claimed element of the patented invention." *Warner Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, ___ U.S. ___, 117 S. Ct. 1040, 1053 (1997). The Supreme Court, in *Warner-Jenkinson*, set forth the essential framework of an equivalence analysis:

> An analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element..

Id. at 1054.

Therefore, in determining whether literal infringement or infringement under the doctrine of equivalents has occurred, each of Lamson's products must be compared to each of the '135 claims at issue.

Lamson's claim of non infringement is based on two elements of the '135 patent which it asserts are not found in its products. The first element, which Lamson calls the "specific insert" requirement, is the requirement in claims 1, 12, and 14 that the weatherproof outlet cover have an insert "within the aperture." The second element, which Lamson calls the "multiple orientation" requirement, is the requirement in independent claims 1 and 12 that the insert fit within the aperture of the base plate in a first orientation and a second orientation. The court will address each of these elements.

A. The "specific insert" requirement

In this case, claims 1, 12 and 14 require that the electrical outlet cover have either "an insert adapted to fit within the aperture of the base plate" (Claim 1), "an insert adapted to be accommodated within the aperture of the base plate" (Claim 12), or "an insert adapted to be accommodated within the aperture in the base" (reexamined claim 14, with certificate of correction). The court, in its *Markman* Order, construed the language "within the aperture" as a limitation meaning "...the insert must have an outer dimension conforming to, or smaller than, the outer dimensions of the aperture to fit *within* the aperture."

Lamson argues none of its products have an insert that fits "within the aperture" because each insert is larger than the aperture of the base of the outlet cover. The court agrees that there is no literal infringement, as the inserts of all of Lamson's products are larger than the outer dimension of the aperture and do not have an outer dimension conforming to, or smaller than, the outer dimensions of the aperture. Summary judgment of no

literal infringement is proper when no reasonable jury could find that every limitation recited in a claim is found in an accused device. *Spectrum Int'l, Inc.*, 164 F.3d at 1380. Because no reasonable jury could find that Lamson's inserts meet the limitation of "within the aperture" as construed by this court, Lamson's accused products cannot literally infringe claims 1, 12 and 14 as a matter of law.

Although literal infringement does not exist, the next step of the inquiry is whether any of Lamson's products at issue infringe under the doctrine of equivalents, a doctrine which was recently upheld in *Warner-Jenkinson*. Under the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is "equivalence" between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson*, 117 S. Ct. at 1045. The doctrine of equivalents is applied element by element, rather than to the invention as a whole. *Id.* at 1049.

In this case, at issue is whether Lamson's inserts have an element that is equivalent to Intermatic's insert "within the aperture." As stated above, Lamson's inserts in each of its products have a structure called "ribs" or "ribbing." This ribbing extends into the aperture of the base and performs mounting and locating functions. Lamson argues this structure cannot be equivalent to Intermatic's insert as a matter of law because of prior art. Specifically, Lamson asserts that the ribbing is the same as ribs found on a GE decorative faceplate sold many years ago and, therefore, should be considered within the public

domain.[6] The court finds that a question of fact exists as to whether the structure found on the GE faceplates: (1) is "within the aperture," and (2) has the same moisture resistance, mounting and locating functions as the ribbing structure in Lamson's inserts. In short, the court leaves to a jury the question of whether any of Lamson's inserts infringe on Intermatic's insert under the doctrine of equivalents.[7]

B. The "multiple orientation" element.

In addition to the specific insert element, claims 1 and 12 require that the inserts be accommodated in multiple orientations. Since this court held in the previous section that Lamson's products do not literally infringe on claims 1, 12 and 14 as a matter of law, the court will

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[6] The GE decorative faceplate was an embodiment of a patent (the Bensten patent) assigned to GE. The patent was considered during the reexamination, and was included in prior art used in an obviousness-type rejection that resulted in modification of claim 14. The GE product was not considered in the reexamination because it did not fall within the scope of prior art considered during a reexamination as set forth in the Manual of Patent Examining Procedure ("MPEP") § 2258. The GE product differs from the Bentsen patent in that GE's faceplate insert has structure depending from the rear wall of the insert surrounding the aperture, created for securing the faceplate to the outlet (i.e., screw holes), which is not described in the patent.

[7] Should a jury determine that Lamson's ribbing is equivalent to an insert within the aperture, the court will then address whether the equivalent structure falls within the range of equivalent as limited by prior art.

address Lamson's argument regarding the multiple orientation element under the doctrine of equivalents.

Lamson argues that its single gang units have symmetrical inserts which present the same orientation when rotated 180 degrees. According to Lamson, symmetrical inserts do not infringe because they do not meet the "first" and "second" orientation limitation of claims 1 and 12.

The *Markman* Order construed a "first orientation" and a "second orientation" to include a 180 degree rotation of the insert. The symmetry of the inserts is dependent upon the apertures therein for accessing the electrical outlet or service device. Claim 5 of the '135 patent, dependent on claim 1, includes the limitation "wherein the insert has an aperture that is substantially rectangular." A rectangle is a shape with symmetry. Therefore, claim 5 appears to preclude Lamson's argument, as some of its single gang units appear to have inserts with a rectangular aperture. The court finds questions of material fact exist as to whether the symmetry element of the inserts found in the Lamson single gang units is identical or equivalent with respect to the multiple orientation element of claims 1 and 12 of the '135 patent. The court leaves the issue of infringement concerning inserts with symmetrical configurations to the trier of fact.

CONCLUSION

For the reasons stated above, Lamson's motion for summary judgment on the issue of non infringement is granted with regard to literal infringement and denied with regard to infringement under the doctrine of equivalents.

/s/
PHILIP G. REINHARD, JUDGE
UNITED STATES DISTRICT COURT

DATED: March 30, 1999

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
WESTERN DIVISION

INTERMATIC INCORPORATED,	)	
Plaintiff,	)	No. 94 C 50295
v.	)	
LAMSON & SESSIONS CO.,	)	
Defendant.	)	

MEMORANDUM OPINION AND ORDER

On January 27, 1999, the court held a hearing pursuant to *Markman v. Westview Instruments Inc.*, 517 U.S. 370 (1996), to resolve the matter of interpreting the disputed claim language in claims 1, 12, 14 and 19 of reexamined United States Letters Patent No. B1 5,280,135 ("patent '135"). The court addresses the language at issue as follows:

1. Defendant asserts that claims 1 and 12, which limit the insert to fit or be accommodated "within the aperture" in a "first orientation" and a "second orientation" do not refer to 180 degree rotations of the insert. In construing patent claims, the court should first examine the words of the claims in defining the scope of the invention. *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1582 (Fed.Cir. 1996). Here, the claims refer to two separate orientations, without limit to the variety of orientations available. Furthermore, dependent claims 3, 16 and 17 limit the orientations of claims 1 and 12, respectively, to vertical and horizontal orientations. The doctrine of claim

interpretation creates a presumption that the use of different words or phrases in separate claims, where the absence of such differences would make the claims superfluous, makes the differences between such claims significant. *Tandon Corp. v. U.S. International Trade Comm'n*, 831 F.2d 1017, 1023 (Fed.Cir. 1987). In addition, the specification must be reviewed to determine whether any terms have beer used in a manner inconsistent with their ordinary meaning. *See Vitronics Corp.*, 90 F.3d at 1582. The specification supports the construction of "first orientation" and "second orientation" to include multiple orientations, not limited to two orientations 90 degrees apart, and describes the insert capable of being "positioned in a plurality of orientations," (Col. 6, lines 23 24) or " fitted in the aperture... in at least two orientations, 90 degrees apart." (Col. 6, lines 34 35). Therefore, the court finds that the claim language and specification support "first orientation" and second orientation" to include orientations 180 degrees separate from one another.

2. As additional support that patent '135 does not encompass the 180 degree rotation, defendant argues that the language "of sufficient size" pertaining to the size of both the aperture and insert requires the aperture to be larger than the aperture of a single gang cover in order to encompass two different rotational positions of an electrical outlet. The plain meaning of the claim language in dispute does not support such a contention. The court has interpreted the rotational positions defined by the "first orientation" and "second orientation" to include 180 degree rotations of the insert, which would not necessarily require a larger aperture or insert. Furthermore, notwithstanding the court's above findings concerning the orientational limitations, defendant's argument contemplates that the claims are limited to a single gang outlet, rather than an

array of electrical outlets. Claims 1 and 12 refer generically to electrical outlets, rather than single gang outlets. The specification explicitly refers to double gang outlets (col. 8, line 5) as a further embodiment of the invention. A double gang outlet would not necessarily require a larger aperture to encompass either 90 or 180 degree rotations, as counsel for Lamson admitted during the Markman hearing. (Tr. 64) Therefore, the court finds that the claim language "of sufficient size" does not mean "larger."

3. Plaintiff asserts that the "aperture" of claims 1, 12 and 14 includes a recess. Words within a claim are generally given their ordinary and customary meaning, unless the patentee chooses to be his own lexicographer. *See Vitronics*, 90 F.3d at 1582. Where the patentee chooses a special definition, however, that definition must be clearly stated in either the patent specification or file history. *Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1578 (Fed. Cir. 1996). A review of the specification and file history shows that the patentee did not assign a special definition for "aperture." Claims 1 and 12 refer to the aperture as being "of sufficient size to accommodate the electrical outlet" in various orientations. This description suggests that the patentee contemplated the aperture as being the hole through which the electrical outlet could be accessed. The specification describes the aperture as having a recess "located along the periphery of the aperture" and assigns separate reference numbers to each of these features. Furthermore, in defining the aperture by reference to the drawings, the specification states, "[t]he aperture 26 has a generally octagonal shape in this embodiment," (Col. 3, lines 21-22), referring specifically to Figures 2-4. Of that set of figures, Figure 4 is the sole drawing which refers to the aperture (26) and the recess (40). The hole through which the electrical outlet or service device would be accessed is

octagonal in Figure 4. The recess surrounding the hole is not octagonal. A review of the claim language and specification leads to the inescapable conclusion that the aperture does not include the recess.

4. Having defined "aperture" above, the court must also construe the meaning of insert as asserted in patent '135. Defendant asserts that the limitation in claims 1 18 requiring the insert be adapted to fit or accommodated "within the aperture" restricts the types of inserts to those with outer dimensions conforming to or smaller than the aperture's outer edge. (Lamson Markman Brief, p. 23). The words of the claims limit the scope of the insert to "within the aperture." The specification describes the preferred embodiment of the insert as follows:

> The insert 14 has a top edge 42, a bottom edge 44 and two side walls 46 and 48. A flange 50 extends around the periphery of the insert 14. The flange 50 is sized and adapted to fit securely within the recess of the base plate 12 in order to form a connection with the base plate 12. A raised ledge 51 is located on the face of the insert 14 around the periphery of the aperture 26 and flange 50.

(Col. 4, lines 5-12) The court construes the above language to describe an insert, separate from, but connected to a flange and a raised ledge. The size of the flange and raised ledge should therefore not be taken into consideration when ascertaining the size of the insert. The notice function of the patent is sufficiently served, by reference to the specification and the drawings, to inform the public that the insert, required by the claims to be "within the aperture" does not include the flange and raised ledge described therein which

clearly do not fit "within the aperture." The flange and the raised ledge are limitations in the specification that were not and should not be imported into the claim language. While it is proper to use the specification to interpret the meanings of words and phrases in the claims, it is improper to import extraneous limitations from the specification into the claims. "By 'extraneous,' we mean a limitation read into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases." *E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988). None of the claims in Patent '135 require the insert to be limited in scope by connection to a flange or a raised ledge. The claims, do, however, specifically require that the insert fit "within the aperture." In order to accomplish this, the insert must have an outer dimension conforming to, or smaller than, the outer dimensions of the aperture to fit ***within*** the aperture. Therefore, this court finds that the insert as described in the claims must have an outer dimension conforming to or smaller than the outer dimensions of the aperture, and does not include the flange and the raised ledge so as to fit "within the aperture."

5. Plaintiff asserts that the amendments made to claim 14 during reexamination resulted in a claim "identical" to the original claim 14 within the meaning of 35 U.S.C. § 252. Specifically, plaintiff contends that the original claim language "mounted in" is substantially identical to the reexamined claim language "within the aperture." The court finds that the amended claim 14 is substantively different from the original claim 14 within the meaning of 35 U.S.C. § 252. The Supreme Court recently established a rule of patent law whereby claim amendments are presumed to have been necessitated by the prior art unless the record clearly indicates otherwise and the burden is placed on the

patent holder to show that the amendments made during patent prosecution were for reasons other than limiting the element to avoid prior art. *Warner Jenkinson Company Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, ___, 117 S. Ct. 1040, 1051 (1997). Here, the examiner required that the language of the original claim 14 be changed to avoid prior art. The examiner's finding of patentability with regard to amended claim 14 was specifically "because of the limitation of the insert being adapted to be accommodated within the aperture of the base." (Reex. Exh. 23) Plaintiff has failed to overcome the presumption that the changes were made for any reason other than that the modification of the language to include this limitation was necessary for patentability.

6. Plaintiff contends that the "release button" of the latching mechanism of claim 19 exists only to ease the movement of the biased pin, and is not essential to such movement, nor is it essential to opening the housing. The court holds that claim 19, as supported by the specification, requires that depression of the release button is essential to opening the latching mechanism. The latching mechanism is comprised of a slotted member, a biased pin and a release button. The function of the latching mechanism in claim 19 is "releasably fixing the housing in a closed position with respect to the base so that access to the service device is prevented." (Col. 10, lines 47-49). The claim language describes the release button as "associated with the biased pin and adapted to facilitate moving the pin in opposition to the biasing to locate the biased pin out of the slotted member." (Col. 10, lines 58-61). The biased pin serves to "secure the housing and the base together when the biased pin is located in the slotted member." (Col. 10, lines 55-58). The specification clearly describes the function of the release button in relation to the latching mechanism. "In order to open the housing 16, the release button 144 is pressed in an

upward direction. This bends the flexible tab 142 upwardly removing the pin 140 from the slot 136. Then the housing 16 can be lifted." (Col. 7, lines 36-39). The specification also describes the latching mechanism as "positively closed and will not tend to open unintentionally or accidentally, for example, by someone inadvertently pulling on the appliance cord." (Col. 7, lines 29-32). The court finds that the language of claim 19 as supported shows that the release button is essential to opening the housing.

CONCLUSION

For the reason stated herein, this constitutes the court's findings of fact and conclusions of law.

ENTER:

/s/
PHILIP G. REINHARD, JUDGE
UNITED STATES DISTRICT COURT

DATED: February 9, 1999

Supreme Court, U.S.
FILED
OCT 7 2002
OFFICE OF THE CLERK

No. 02-193

IN THE

Supreme Court of the United States

INTERMATIC INCORPORATED,
Petitioner,

v.

THE LAMSON & SESSIONS CO.,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

KENNETH R. ADAMO
CALVIN P. GRIFFITH
THOMAS R. GOOTS
JONES, DAY, REAVIS & POGUE
901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-3939

GREGORY A. CASTANIAS
(Counsel of Record)
LAWRENCE D. ROSENBERG
MICHAEL S. FRIED
JONES, DAY, REAVIS & POGUE
51 Louisiana Ave., N.W.
Washington, D.C. 20001
(202) 879-3939

Counsel for Respondent

QUESTION PRESENTED

Whether petitioner has made a sufficient showing to merit a grant of certiorari, vacatur, and remand in light of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831 (2002), where petitioner's sole argument for GVR relief is not dependent upon *Festo*, was rejected by the court of appeals on grounds unaffected by the *Festo* decision, and has been again rejected by the court of appeals since this Court's *Festo* decision.

CORPORATE DISCLOSURE STATEMENT

Respondent The Lamson & Sessions Co. is a publicly traded corporation. No parent or publicly held company owns 10% or more of its stock.

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RESPONDENT'S BRIEF IN OPPOSITION

The petition for certiorari should be denied. Although petitioner seeks GVR relief in light of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831 (2002), it offers only one argument in favor of GVR, and it is clear that this argument does not depend at all on this Court's decision in *Festo*. Rather, petitioner's argument is one that has been rejected by the Federal Circuit at every turn since 1985, was rejected by the Federal Circuit in this case, and has been again rejected by the Federal Circuit in the months *since* this Court's decision in *Festo*. Because this lone argument does not demonstrate a reasonable probability that the decision below would in any way be altered in light of this Court's decision in *Festo*, the petition should be denied.

STATEMENT

1. Petitioner Intermatic Incorporated ("Intermatic") initiated these two patent-infringement actions against respondent The Lamson & Sessions Co. ("Lamson") claiming that certain plastic weatherproof covers for electrical outlets manufactured by Lamson infringed U.S. Letters Patent No. 5,280,135 ("the '135 Patent"), which issued in January 1994 and was assigned to Intermatic, and which was reexamined in 1996-97. Pet. App. 1a-2a. The '135 Patent describes an electrical outlet cover, consisting of a base plate into which inserts are fitted. The inserts have openings for various outlet configurations, and an appropriately configured insert can be selected and placed into the aperture of the base plate to cover a particular outlet. The object of the patent was to fit numerous potential configurations using just one common base and housing. Pet. App. 2a, 7a; C.A. App. A169, col. 7, line 62-col. 8, line 59.

2. The '135 Patent has nineteen claims. Only one claim limitation, present in all but one of the patent's independent claims (claims 1, 12, 13, and 14), is relevant here. That limitation requires the "insert" fitted into the outlet cover's base plate to be "within the aperture" of the base plate. Pet. App. 3a; C.A. App. A169, col. 8, line 52; A170, col. 9, lines 43-44, 59-

60; A173, col. 2, lines 13-14. Prior to the patent's reexamination, claim 14 stated that the insert merely had to be "adapted to be mounted in the base"of the outlet cover. Pet. App. 4a. After an amendment to overcome the patent examiner's rejection during the reexamination, claim 14 states that the insert must be "adapted to be accommodated with[in] the aperture" of the base of the outlet cover. *Id.*

3. A request for reexamination of the '135 patent was filed on September 21, 1995.*

a. On March 6, 1996, the United States Patent and Trademark Office ("the PTO") rejected claims 1, 3-12, and 14-18 of the '135 patent as obvious in light of the prior art. Specifically, the PTO noted that another patent, U.S. Letters Patent No. 2,980,283, issued to Arthur R. Bentsen in 1961 (the "Bentsen Patent") had already disclosed the use of inserts over a baseplate to cover electrical outlets. The PTO concluded that it would have been obvious to incorporate this system of inserts into a *weatherproof* outlet cover, which had been disclosed in U.S. Letters Patent No. 4,381,063, issued to Henry Leong in 1983. C.A. App. A922-23; A1053. The prior art also contained numerous other patents disclosing designs for outlet covers involving bases with protective housings, some including plate inserts. C.A. App. A389-90; A392; A469-70; A878; A909-15.

b. Intermatic overcame these obviousness rejections (1) by arguing that the prior art only disclosed covers where

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* Reexamination is a "procedur[e] under which the patent owner or any person may (1) cite to the PTO patents or printed publications as prior art pertaining to the validity of claims in the patent, and (2) request that the PTO reexamine any claim of that patent on the basis of the cited prior art." Donald A. Chisum, 4 *Chisum on Patents*, § 11.07[4] at 11-385 to 11-386 (2001). If the PTO determines that the cited prior art raises "a substantial new question of patentability," "the claim or claims in question are reexamined according to the procedures for initial examination." *Id.* at 11-386.

inserts were mounted "over" an aperture in the base plate, and not "within" the aperture, and (2) by amending some claims to incorporate the "within the aperture" limitation. As to independent claim 1 of the patent, Intermatic distinguished the Bentsen Patent and other patents by arguing at a November 25, 1996 interview with the patent examiner that the prior art only rendered obvious inserts "over" the aperture of the base plate, but not "within" the aperture, and by assuring the PTO that claim 1 was limited to the latter sort of insert, which is "within" the aperture. Addendum to Brief of Defendant-Appellee in No. 01-1028, *Intermatic, Inc. v. Lamson & Sessions Co.* at 5-12. Correspondingly, Intermatic overcame the obviousness rejection of claim 14, which previously required only that the insert be "adapted to be mounted in the base," by agreeing on September 8, 1997 to narrow that limitation by amending it to its current language, which includes the "within the aperture" limitation already present in claim 1. *Id.* at 14-15; C.A. App. A1055.

c. Importantly, during the reexamination proceeding, Intermatic's counsel presented to the PTO, as early as April 18, 1996, actual samples of the actual Lamson outlet covers Intermatic accused of infringement in this case, C.A. App. A960, A964-65, yet Intermatic still did not obtain literal coverage of that design in the reexamined patent that ultimately issued. C.A. App. A960; A964-65; A1055.

4. Intermatic initiated its first suit against Lamson ("*Intermatic I*") in September 1994, charging that certain Lamson outlet covers infringed seventeen of the nineteen claims in the '135 Patent. Pet. App. 7a

a. Even though the accused covers in *Intermatic I* did not fit "within the aperture" of the base plate as required to infringe the asserted claims of the '135 Patent, but rather were mounted in a frame *over* the opening, the district court permitted the case to proceed to the jury to decide the question whether certain narrow plastic "ribs" protruding from the

accused Lamson insert plates constituted the equivalents of inserts "within the aperture." Pet. App. 7a. The district court did so despite evidence that the Bentsen product, which GE sold in the 1960s, also had small "ribs" of material surrounding the screwhole in the insert that projected into the aperture. C.A. App. A156-57.

b. After the district court had issued a summary-judgment ruling making clear that *only* the ribs of Lamson's accused products presented any risk of infringement, Lamson changed its molds, obtained approval for a ribless design that was identical in all other pertinent features to the accused ribbed design, and put on the market outlet covers using these new "ribless" inserts. Pet. App. 7a-9a; C.A. App. A1850-53; A1867-70.

c. The jury in *Intermatic I* ruled for Intermatic, finding that the Lamson covers infringed claims 1, 3, 4, 6-9, and 11-18 of the '135 Patent under the doctrine of equivalents. Pet. App. 8a. The jury concluded that claims 5 and 10 were not infringed. C.A. App. A157.

5. In December 1999, after *Intermatic I* had proceeded to final judgment, Intermatic filed a second patent-infringement suit against Lamson ("*Intermatic II*") charging that the redesigned "ribless" Lamson covers also infringed the '135 Patent. Pet. App. 9a. The district court granted summary judgment of noninfringement in favor of Lamson in *Intermatic II*, holding that Intermatic's conduct during the prosecution history of the '135 Patent gave rise to prosecution-history estoppel with regard to covers lacking any structure "within the aperture." Pet. App. 9a.

6. The Federal Circuit reversed the judgment of infringement in *Intermatic I* and affirmed the judgment of noninfringement in *Intermatic II*.

a. The Court of Appeals agreed with the district court that the Lamson covers in the two cases did not literally

infringe the '135 Patent. Pet. App. 15a-16a. The Federal Circuit also concluded that Intermatic's narrowing of the "insert" limitation (from "mounted in the base" to "within the aperture" of the base) during the prosecution of the '135 Patent precluded its claim of infringement by equivalents. Pet. App. 16a-21a.

b. With respect to claim 14, the majority reasoned that the narrowing of that claim during reexamination in order to avoid an obviousness objection disclaimed covers using inserts merely "mounted in the base," but not "within the aperture" of the base. Pet. App. 17a. It cited the Federal Circuit's *en banc* decision in *Festo* to support its conclusion that Intermatic's claimed equivalent was unavailable. *Id.*

c. With respect to claim 1, the majority observed that under the Federal Circuit's prior decision in *Builders Concrete, Inc. v. Bremerton Concrete Products Co.*, 757 F.2d 255 (Fed. Cir. 1985), "any estoppel generated by [a narrowing amendment in one claim] applies to all other claims in the patent containing that limitation." Pet. App. 18a-19a. Because claim 1 included the same "within the aperture" limitation as claim 14, the majority held that prosecution-history estoppel foreclosed Intermatic from obtaining liability under the doctrine of equivalents for that claim as well. Pet. App. 19a-20a.

d. The Federal Circuit's ruling was not "a 2-1 decision," as the petition claims (Pet. 6), but a 3-0 decision. The only division on the panel was the result of Judge Newman's separate *concurring* opinion. Pet. App. 24a-25a. Judge Newman, who dissented from the Federal Circuit's *en banc* ruling in *Festo*, opined that in her view the absolute bar of the Federal Circuit's *Festo* decision did *not* apply, but that nonetheless, "[o]n review of the facts and the law of this case, I reach the same result as does the court." Pet. App. 24a.

7. a. On April 18, 2002, and May 28, 2002, Intermatic applied for and was granted extensions of time for filing its

petition for certiorari so that it could address this Court's imminent ruling in *Festo*.

b. Also on May 28, 2002, this Court issued its opinion in *Festo*. In that decision, this Court replaced the Federal Circuit's absolute bar (against application of the doctrine of equivalents after a narrowing amendment) with a *presumption* of an absolute bar, which this Court stressed could only be overcome by a showing that, at the time of the narrowing amendment, one of ordinary skill in the art could not have been expected to draft a claim that would literally encompass the known equivalent:

> A patentee's decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim. . . . There are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases, the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence. . . . *The patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.*

122 S. Ct. at 1842 (emphasis added; citations omitted).

c. On July 5, 2002, well over a month after this Court's decision in *Festo*, Intermatic filed its petition for certiorari in this Court.

d. On August 1, 2002, the Federal Circuit decided *Allen Engineering Corp. v. Bartell Industries, Inc.*, 299 F.3d 1336

(Fed. Cir. 2002), which reaffirmed that, even after this Court's decision in *Festo*, an "estoppel affecting a limitation in one claim will also extend to all claims in which that limitation appears." *Id.* at 1350 (quoting *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1584 (Fed. Cir. 1995)).

REASONS FOR DENYING THE PETITION

The petition fails to offer any legitimate basis for the GVR relief it seeks. Petitioner argues that it is entitled to GVR because, if the Court of Appeals had applied the rebuttable presumption of a complete bar articulated in this Court's *Festo* decision, "it would have concluded that Intermatic did not surrender the particular equivalents at issue *because asserted claims were already allowed at the time of the narrowing amendment to claim 14*." Pet. 7-8 (emphasis added). This claim is triply flawed. *First*, it does not even attempt to address the GVR standard established by this Court's decisions. *Second*, the petition does not argue that the aspect of *Festo* that was altered by this Court could possibly affect the outcome of this case. *Third*, the lone argument it does offer for GVR has been repeatedly rejected both before and after this Court's *Festo* decision, so there is no possibility that this argument would yield a different result in the case of a remand.

1. Intermatic ignores the GVR standard established by this Court's decisions. Under that standard, Intermatic must demonstrate that

> intervening developments, or recent developments that [this Court] ha[s] reason to believe the court below did not fully consider, reveal a reasonable probability that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration, and where it appears that such a redetermination may determine the ultimate outcome of the litigation.

Lawrence v. Chater, 516 U.S. 163, 167 (1996). Thus, Intermatic must show that this Court's intervening *Festo*

decision is "sufficiently analogous and, perhaps, decisive to compel re-examination of the case." *Henry v. City of Rock Hill*, 376 U.S. 776, 777 (1964); *see generally* Robert L. Stern & Eugene Gressman, *Supreme Court Practice* 317-20 (8th ed. 2002).

Intermatic not only ignores the foregoing authorities, but wholly neglects the standard they impose. Intermatic's only effort to explain why this case meets the standard for GVR is its observation that "several *other* cases" have been remanded in the wake of *Festo*. Pet. 8 (emphasis added). But the existence of some *other* cases that have rested upon premises that have been undermined by this Court's *Festo* decision in a way that could affect their outcomes says nothing about whether *this* case rests upon such a premise affected by this Court's *Festo* decision.

2. Intermatic's petition fails to satisfy the applicable standard for GVR. It makes no effort to show that the test this Court set out in *Festo* could possibly be applied in a way that would alter the outcome of this case. Indeed, its only discussion of *Festo*'s application is its vague claim that the Federal Circuit needs to decide anew "whether the patent owner 'can demonstrate that the narrowing amendment[] did not surrender the particular equivalents at issue.'" Pet. 7 (quoting *Festo*, 122 S. Ct. at 1842 (section of opinion addressing the remand of that particular case)).

In fact, however, this Court in *Festo* explained precisely what is required in order to demonstrate that an equivalent is "surrender[ed]," yet Intermatic does not even allege that it could make that showing here. *Festo* held that "surrender" is *presumed* by the fact of a narrowing amendment for the purpose of securing patentability, 122 S. Ct. at 1842, and that the burden then shifts to the patent owner (here, Intermatic) to rebut that presumption. *Id.* Moreover, the Court held that to rebut the presumption of surrender, Intermatic is required to show that "at the time of the amendment one skilled in the art

could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent." *Id.*

Intermatic does not dispute that its narrowing amendment of claim 14 triggered the presumption of surrender. But the more important point is this: Intermatic does not allege that, at the time of that amendment, it could not reasonably have been expected to draft a claim literally encompassing Lamson's outlet covers — and that would have been a very difficult argument for Intermatic to make, since Intermatic actually had the accused Lamson outlet covers in hand when it made that narrowing amendment. Because Intermatic does not even address the governing standard under *Festo*, or explain how a remand could possibly result in a different outcome under the applicable standard, it has failed to articulate any legitimate basis for GVR.

3. The one argument for GVR that Intermatic does offer has nothing to do with whether there is an estoppel here, but only whether the estoppel applies to the same term in other claims. That argument is irrelevant to and unaffected by *Festo*, and has been rejected by the Federal Circuit both before and — more importantly — *after* this Court's *Festo* decision. This demonstrates that there is no "'reasonable probability' that the Court of Appeals would reject [this] legal premise on which it relied," *Taylor v. Cain*, 533 U.S. 656, 666 n.6 (2001), and therefore no likelihood whatsoever of a different result upon remand.

a. Intermatic argues that its narrowing amendment of claim 14 did not surrender coverage of the Lamson covers "because asserted claims" — *i.e.*, claim 1 and its dependent claims — "were already allowed at the time of the narrowing amendment to claim 14." Pet. 8. In other words, Intermatic does not dispute that the narrowing amendment to the "mounted in the base"/"within the aperture" claim limitation in claim 14 works an estoppel; nor does Intermatic claim that it could possibly overcome the presumptive absolute bar with

respect to that claim limitation. Instead, Intermatic merely argues, as it did below, that the estoppel caused by the amendment to claim 14 does not carry over to the identical "within the aperture" limitation of claim 1. This argument, of course, does not even purport to make the necessary showing under *Festo* — that Intermatic "could not reasonably [have] be[en] expected to have drafted a claim that would have literally encompassed the alleged equivalent." 122 S. Ct. at 1842. Rather, it is simply an argument that an admitted estoppel as to a limitation appearing in one claim should not be carried over to the identical limitation in another claim, whether or not the second claim was amended.

This, of course, is not a question affected by *Festo*, because the *fact* of estoppel as to the claim 14 limitation is undisputed. Rather, Intermatic's petition presents the question, unaffected by *Festo*, of whether the admitted estoppel in the one claim *carries over* to the same limitation in another claim. And here, on this latter question, the Federal Circuit has repeatedly and unwaveringly rejected Intermatic's argument in a line of cases independent of *Festo*. These cases hold that amendment-based prosecution-history estoppel "will apply to that term in other claims." *Southwall*, 54 F.3d at 1584. Thus, in *Builders Concrete*, the court of appeals held that "[t]he fact that the [relevant] clause of patent claim 10 was not itself amended during prosecution does not mean that it can be extended by the doctrine of equivalents to cover the precise subject matter that was relinquished in order to obtain allowance of claim 1." 757 F.2d at 260; *see also Am. Permahedge, Inc. v. Barcana, Inc.*, 105 F.3d 1441, 1445 (Fed. Cir. 1997) (similarly applying prosecution history estoppel to the same element in an unamended claim); *Alpex Computer Corp. v. Nintendo Co.*, 102 F.3d 1214 (Fed. Cir. 1996) (same).

Importantly, the Federal Circuit has reaffirmed this principle *since* this Court's ruling in *Festo*, again holding that prosecution-history estoppel as to a single limitation extends "to all claims in which that limitation appears." *Allen Eng'g*,

299 F.3d at 1350 (citing *Southwall*, 54 F.3d at 1584). These decisions foreclose Intermatic's argument that the PTO's allowance of claim 1 entitles Intermatic to a broader range of equivalents with regard to the phrase "within the aperture" in claim 1 than with regard to the exact same element in amended claim 14. The Court of Appeals expressly based its decision below on this principle, which this Court's *Festo* decision does not affect. *See* Pet. App. 19a (concluding "that the principles espoused in *Builders* equally apply to a claim limitation that was narrowed in order to obtain allowance of a claim during reexamination, despite the fact that the resulting estoppel may retroactively extend to original, unamended claims"). There is therefore no possibility that the intervening decision of this Court in *Festo* could affect the judgment of the Court of Appeals in this case.

b. It is understandable why Intermatic does not even try to explain how this Court's decision in *Festo* could possibly alter the outcome of this case. Intermatic could not possibly have met its burden of showing that it has any reasonable likelihood of overcoming the *Festo* presumption on remand. The '135 Patent, after all, is for a plastic outlet cover, not some technologically complex device where it would have been difficult to describe the claimed equivalents. *See* Brief for the United States in No. 00-1543, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* at 27 (suggesting that rebuttal of the presumption of surrender will be most likely where complex technology is at issue).

In order to rebut the *Festo* presumption, Intermatic would have had to have shown that, "at the time of the amendment," it could not reasonably have been expected to draft claim language literally covering the Lamson products. But Intermatic's counsel actually presented to the PTO samples of the very Lamson covers they accused of infringement, and with the accused devices in hand would have had no problem drafting language literally covering those devices — such as, for example, a patent claim incorporating a description of

inserts "with ribs extending into the aperture." C.A. App. A960; A964-65; A1055. (Nor were the Lamson covers the first in this field to use such ribs. The Bentsen product, too, which was sold by General Electric in the 1960s, has similar small ribs of material surrounding the screw hole that projected down into the aperture. C.A. App. A156-57.)

c. The irrelevance of *Festo* to the panel's decision in this case is confirmed by Judge Newman's concurring opinion below. Judge Newman, who dissented from the absolute-bar holding of the Federal Circuit's *Festo* decision, wrote separately to *concur* in the judgment in this case, emphasizing that even though she believed that the complete bar did not apply in this case, Pet. App. 24a-25a, she nonetheless "reach[ed] the same result as d[id] the court." Pet. App. 24a. Thus, the concurrence of Judge Newman confirms that the outcome of the case below did not in any way depend upon the complete bar this Court rejected in its *Festo* decision. *See* Pet. App. 20a n.3 (majority opinion; noting that Judge Newman's concurrence analyzed the estoppel as to the unamended claims "under the flexible bar rejected in *Festo*," but reached the same result).

4. Finally, petitioner's subsidiary complaint that failure to GVR would subject Intermatic to "disparate treatment under the law," Pet. 8, is meritless. It is not disparate treatment to remand cases whose holdings are legitimately called into question by *Festo*, but not remand other, different cases — such as this case — whose holdings are not affected by *Festo*.

Moreover, unlike the other petitioners to whom it points, Intermatic requested and received extensions of time to file its petition so that it could address this Court's decision in *Festo*, and it was not required to file its petition until over a month *after* this Court issued its decision in *Festo*. Once consequence of this delay, of course, is that we now know that the Federal Circuit has again rejected, even after *Festo*, the sole argument for GVR offered by Intermatic. But Intermatic's later filing

also demonstrates that Intermatic was not similarly situated to those other petitioners — it, unlike those other petitioners, had this Court's *Festo* decision in hand, and therefore knew precisely what it would be obligated under *Festo* to explain: how it could "show at the time of the amendment [that] one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed" the Lamson covers. 122 S. Ct. at 1842. Intermatic did not make that showing, because it could not.

CONCLUSION

For the foregoing reasons, the petition for certiorari should be denied.

Respectfully submitted,

KENNETH R. ADAMO
CALVIN P. GRIFFITH
THOMAS R. GOOTS
JONES, DAY, REAVIS & POGUE
901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-3939

GREGORY A. CASTANIAS
(*Counsel of Record*)
LAWRENCE D. ROSENBERG
MICHAEL S. FRIED
JONES, DAY, REAVIS & POGUE
51 Louisiana Ave., N.W.
Washington, D.C. 20001
(202) 879-3939

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In The

Supreme Court of the United States

INTERMATIC INCORPORATED,

Petitioner,

v.

THE LAMSON & SESSIONS CO.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

REPLY TO BRIEF IN OPPOSITION

JOHN K. LUCAS
(*Counsel of Record*)
HAROLD V. JOHNSON
TIMOTHY Q. DELANEY
MARK H. REMUS
BRINKS HOFER GILSON & LIONE
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, Illinois 60611
(312) 321-4200
Counsel for Petitioner

COCKLE LAW BRIEF PRINTING CO. (800) 225-6964
OR CALL COLLECT (402) 342-2831

REPLY TO BRIEF IN OPPOSITION

The clearest case for GVR is where the decision of the lower court was based on a rule of law that has since been rejected by an intervening decision of this Court. *Lawrence v. Chater*, 516 U.S. 163, 166 (1996).[1] The instant case satisfies the standard articulated in *Lawrence* (*i.e.*, the intervening decision is "sufficiently analogous, and, perhaps, decisive") because the Federal Circuit's decision was based squarely on the very decision that was vacated by *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushki Co.*, 122 S. Ct. 1831 (2002). As such, this Court's decision in *Festo* is *per se* decisive. GVR is appropriate in this case for the same reason it was appropriate in the numerous other cases for which this Court granted GVR in light of *Festo*. *See* Pet. 8; *see also Talbert Fuel Sys. Patents v. Unocal Corp.*, No. 02-90, 2002 WL 1611491 (October 7, 2002); *Simple Tech., Inc. v. Dense-Pac Microsystems, Inc.*, No. 01-1787, 2002 WL 1304925 (October 7, 2002). Lamson makes no attempt to distinguish the present case from the cited cases.

Contrary to Lamson's suggestion, Intermatic does not need to prove that the Federal Circuit would reach a different result on remand in order to justify GVR. GVR is not a decision on the merits, but simply a remand to the appellate court so that it may consider a binding decision

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[1] Even the dissent in *Lawrence* noted that GVR is necessary in view of intervening law to "preserve the operational premise of a multitiered judicial system (viz., that lower courts will have the first opportunity to apply the governing law to the facts) and to avoid the unseemliness of holding judgments to be in error on the basis of law that did not exist when the judgments were rendered below." *Id.* at 181 (Scalia, J., dissenting).

that was not previously before it. *See Henry v. City of Rock Hill*, 376 U.S. 776, 777 (1964).

Even though Intermatic need not show that the remand will lead to a different result, Intermatic's petition provides a strong reason why the Federal Circuit would reach a different result (Pet. 7-8). Lamson's citation of *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336 (Fed. Cir. 2002) did not change the rule that, given a clear indication, the identical term *can* have a different range of equivalents in different claims. *Am. Permahedge, Inc. v. Barcana, Inc.*, 105 F.3d 1441, 1446 (Fed. Cir. 1997). Such a clear indication is present in this case because Intermatic did not surrender any equivalents relating to claims that previously had been allowed.

Moreover, Lamson's attempt to force Intermatic to defeat a post-*Festo* defense based on a pre-*Festo* record is inappropriate. The estoppel analysis announced in *Festo* raises a number of factual and legal questions that the parties have not discovered or briefed (Pet. 7-8). The Federal Circuit has recognized that pending cases may require additional briefing and fact finding in order to answer the questions presented under the new *Festo* estoppel analysis. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushki Co.*, 304 F.3d 1289 (Fed. Cir. 2002) (ordering briefing on remand regarding, *inter alia*, whether the estoppel analysis involves questions of law or fact, the role of the jury, and the need for further fact finding in the district court). This is not a court of first impression – the questions raised in this Court's *Festo* decision must be addressed for the first time in the court(s) below.

GVR is proper in this case. GVR guarantees Intermatic full and fair consideration of its rights in light of the

intervening *Festo* decision. To protect judicial integrity, the Federal Circuit should be given the opportunity to reconsider its holding in view of the new rule of law articulated in the intervening *Festo* decision.

Respectfully submitted,

JOHN K. LUCAS
(*Counsel of Record*)
HAROLD V. JOHNSON
TIMOTHY Q. DELANEY
MARK H. REMUS
BRINKS HOFER GILSON & LIONE
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, Illinois 60611
(312) 321-4200

Counsel for Petitioner,
Intermatic Incorporated